



IN THE U.S. PATENT OFFICE

BOARD OF PATENT APPEALS AND INTERFERENCES



AMENDED BRIEF OF
APPELLANT RODGER BURROWS

UNDER 37 C.F.R § 1.191 AND 37 C.F.R. § 41.37

IN RE: The Application of:

INVENTOR: Rodger Burrows

GROUP ART UNIT: 3622

SERIAL NO.: 09/910,654

EXAMINER: Myhre, James W.

FILING DATE: 7/20/01

TITLE: METHODS AND APPARATUS FOR ELECTRONICALLY
STORING TRAVEL AGENT COUPONS

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September 21, 2005

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The following brief is hereby submitted in accordance with 37 C.F.R. § 1.191
and 37 C.F.R. § 41.37

1. REAL PARTY IN INTEREST

Rodger Burrows is the real party in interest.

2. RELATED APPEALS AND INTERFERENCES

A previous appeal before this board was had in Appeal No. 2004-2110. There
are no other related appeals and interferences.

3. STATUS OF CLAIMS

Claims 1-15 and 17-18 are pending in the application and are the subject matter of this appeal as follows:

Claim 1. Once amended in accordance with the amendment filed and mailed on July 7, 2003, stands rejected.

Claim 2. Unamended; stands rejected.

Claim 3. Unamended, stands rejected

Claim 4. Unamended, stands rejected.

Claim 5. Unamended, stands rejected.

Claim 6. Unamended, stands rejected.

Claim 7. Unamended, stands rejected.

Claim 7. Unamended, stands rejected.

Claim 9. Unamended, stands rejected.

Claim 10. Unamended, stands rejected.

Claim 11. Unamended, stands rejected.

Claim 12. Unamended, stands rejected.

Claim 13. Unamended, stands rejected.

Claim 14. Unamended, stands rejected.

Claim 15. Once amended in accordance with Appellant's communication of October 17, 2003, stands rejected

Claim 16. Original . Cancelled.

Claim 17. Once amended, stands rejected.

Claim 18. Unamended, stands rejected.

4. STATUS OF AMENDMENTS

The amendment filed on July 17, 2003 was entered by the Examiner.

The amendment filed on October 17, 2003 comprising an amendment under 37 C.F.R. 1.129 (a), was not initially entered by the Examiner in accordance with his communication of October 28, 2003. However, in response to an inquiry by the BPAI, the Examiner subsequently entered said amendment. Thus, the claims in issue in this appeal are 1-15, 17 and 18.

5. SUMMARY OF THE INVENTION

The invention herein comprises methods and apparatus for electronically generating, and storing airline agency coupon data whereby the data is simultaneously and uniquely generated with the printing of an airline ticket, which data is then stored electronically in data storage apparatus in a director/directory/data file, the data being given an identifier, which data is thereafter retrieved and printed in a format of a prior art agent coupon. (Claim 1, Fig. 1, Spec. p.7-8).

The inventive method and apparatus uniquely generates the coupon data while the travel agent prior art reservation system prints the airline ticket. (Fig. 1, Spec.: p. 7, lines 20-24). However, unlike the prior art reservation system, the agent coupon is not printed. (Fig. 1, Spec. p. 9, 10). The invention advantageously eliminates the prior art printing of an agent coupon and allows the uniquely generated coupon data to be

electronically stored as data and not an image while allowing the data to be retrieved at a later time and printed as an actual facsimile of the agent coupon. (Fig. 1, Spec. p. 9, 10). Since the agent coupon is not printed at the time that the airline ticket is printed, the need for the travel agent to store the vast numbers of printed agent coupons is eliminated. Moreover, the invention does not require a travel agent to produce a paper agent coupon, copy the same and then store the copy prior to discarding the paper coupon. (Fig. 1, Spec. pgs 1-3).

The above summary of the invention is present in independent claims 1 and 15 to which patentability arguments are being made.

6. ISSUES

ISSUE NO. 1

Whether the Examiner's rejection of claims 1-15 and 17,18 under 35 U.S.C. 103(a) is proper on the basis that "although ARC in its entirety seems to suggest an optical storage of image data, the artisan would have found it obvious to also store the image data in electronic form for subsequent reconstruction as an image.", notwithstanding the new evidence and argument submitted by Applicant in his Request to Reopen Prosecution and Response of March 25, 2005.

ISSUE No. 2

Whether the Examiner's rejections of claims 1-5 and 17, 18 under 35 U.S.C. § 103(a) is proper on the basis that the mention of the unacceptability of

hard drives and other nonmagnetic media teaches one of ordinary skill in the art that the agent coupon image could be stored on optical media and magnetic media.

7. GROUPING OF CLAIMS

Inasmuch as the sole basis for rejecting the two independent claims 1 and 15 comprise the same issue stated above, this appeal can consider that all of the claims fall or stand together as one group.

8. ARGUMENT

- i.) The claims were not rejected under 35 U.S.C. 112, first paragraph; therefore, no argument is made in this regard.
- ii.) The claims were not rejected under 35 U.S.C. 112, second paragraph; therefore, no argument is made in this regard.
- iii.) The claims were not rejected under 35 U.S.C. 102; therefore, no argument is made in this regard
- iv. An argument is presented to the above stated issue, i.e. the examiner erroneously rejected claims 1-15 and 17, 18 under 35 U.S.C. 103(a).
- v. No arguments are presented regarding any ground of rejection not covered above.

A. Applicant's Arguments In Opposition To The Examiner's Rejection Under 35 U.S.C. § 103(a)

1. Brief Background

A brief summary of the relationship of the parties referred to in the documents submitted by Applicant and which form part of the record on appeal is deemed helpful to allow the board to fully consider the issues herein. This relationship summary is not new argument; all is contained within the submitted documents. Applicant is an individual who operates an independent travel agency. The Airline Recording Corporation (ARC) is an quasi independent organization funded by the airline industries that interfaces with independent travel agencies that issue airline tickets and from time to time issues policy statements intended to further the goals of the airline industry and provide uniformity to the issuing of airline tickets by the independent travel agencies and the records kept by the travel agencies. Thus, ARC may be said to be the policy arm of the airline industries vis-a-vis the independent travel agencies in the field of airline reservations, tickets, and associated records. The entire body of the travel agents must conform to the dictates issued by ARC. The Industries Agency Handbook (IAH), issued by ARC contains all of the policies that the independent travel agents must comply with in order to be approved by ARC and be allowed to issue airline tickets.

Each travel agency has equipment known as the travel agent reservation system which is used to generate all of the documents required by ARC and concerned with the issuance of an airline ticket by the travel agent. One of the required documents is called an agent coupon. The agent coupon contains all of the data concerning the airline ticket and is the only record kept that allows ARC , the airlines, and the travel

agent to later review the ticket transaction. A long standing requirement of ARC was to have the travel agents keep hard, paper copies of the agent coupon for a minimum of two years. Obviously, the same was as great inconvenience to the travel agents. Recently, ARC somewhat relented on this policy and allowed the travel agents to maintain the actual image of the agent coupons on film (microfiche) or other optical medium. The storage of the **data** on the agent coupon was and still is prohibited by ARC. ARC still requires the **image** of the coupon to be stored. ARC has never disclosed a method by which the image of the coupon is stored. ARC has only issued the requirement that the image be stored.

Applicant does not work for ARC; rather Applicant is an independent travel agent

Another party reflected in the documents submitted by Applicant is the Travel Weekly News which is a weekly publication, apparently independent, that reports on various travel related news, which news is accessible to the independent travel agencies. Upon information and belief, Travel Weekly News is a completely independent news organization and not connected with ARC or the travel agents. As further reflected in the submitted documents, the Travel News Weekly reports on Agent Issues which concern ARC's policies and requirements in general, and in particular, the subject matter of the invention herein.

As noted above, in further of its control of the documents generated by the travel agents, ARC issues an Industries Agent Handbook (IAH) that is required to be followed by the independent travel agents. In accordance with the IAH, travel agents

are required to create and retain physical copies of agent coupons for a minimum of two years. This requirement is stated in the application under the Description of the Prior Art. Further information of the data contained on the agent coupons and the requirement for the long time storage of the same is also recited in the application in the Description of the Prior Art.

Since Applicant is an independent travel agent, he was fully knowledgeable of the desire and efforts by the travel agents to eliminate the agent coupon two year storage requirement and the only relaxation of the requirement offered by ARC. Applicant also realized that ARC's relaxation of the rules (its new policy) was of no real benefit to the travel agents. The relaxation merely allowed the travel agent to destroy the paper copy of the agent coupon after it was printed and its image was stored on film or an optical medium (which did not include a hard drive). Thus, ARC's new policy eliminated the requirement to store paper agent coupons but in its place required the agents to expend the effort and time to transfer the image to film or an optical medium. Applicant knew there had to be a better solution to this problem. The better solution is Applicant's invention which does not store an image of the agent coupon. After months of effort, trial and error and research, Applicant perfected his invention which involves a method contrary to ARC's proposed solution. Applicant made arrangements with ARC to meet with authorized representatives and demonstrate his invention. After the demonstration of the operation of the invention, ARC's representatives reported that it produced the unexpected result of storing data which thereafter could be used to print an actual facsimile of the agent coupon.

Interestingly, while ARC to this day still requires the storage of the image of the agent coupon, ARC copied Applicant's invention and has subsequently implemented Applicant's invention as a paid service to travel agents. Upon learning of this information, Application successfully petitioned to make the application special. The special status continues to date.

All of the above background information is documented in the prior art submissions by applicant and is believed to be an accurate summary of the same.

2. Legal Arguments

In the final rejection of May 24, 2005, the examiner rejected all claims under 35 U.S.C. § 103(a) as being unpatentable over ARC references submitted by applicant.

Applicant submits that independent claims 1 and 15 are patentable and hence, all claims dependent thereupon are also patentable. Accordingly applicant's argument will be restricted to the error by the examiner in rejecting these claims.

A. Concise Explanation Of The Subject Matter Of The Claims

Claims 1 and 15 comprise a methods claim and an apparatus claim respectively. The subject matter of these claims are directed to methods and apparatus to eliminate the necessity to print and store paper copies of agent coupons as done in the prior art but yet provide for ability to retrieve the coupon data and print an actual agent coupon as the need arises. The inventive subject matter comprises a combination of the elements of the invention as referred to in the patent application as follows:

1. A method for electronically generating, storing, and retrieving airline ticket agency coupon data, (Fig. 1, Spec.: p.4, lines 19-22, 24-25, p. 5: lines 1-3) comprising the steps of:

generating agent coupon data (Fig. 1 item. 13) simultaneously with the printing of an airline ticket (Fig.1 item 12, Spec.: p. 7, lines 21-22);

transmitting and storing said agent coupon data electronically to and in data storage apparatus (Fig. 1 item 15, Spec.: p. 8, lines 3-5);

providing each agent coupon data with an identifier (Spec.: p. 8, lines 9-13;

storing said agent coupon data in a director/directory/image file arrangement (Spec.: p. 8, lines 17-20); and

retrieving said electronically stored agent coupon data (Fig. 1 item 17, Spec.:p 9, lines 10-23) and printing the same in the format of an agent coupon (Fig.1 item 19, Spec.:p. 9, lines 23-25, p. 10, lines 4-9)

15. Apparatus adapted to generate, transmit, store and retrieve airline agent coupon data (Fig. 1, Spec.: p.4, lines 19-22, 24-25, p. 5: lines 1-3), comprising:

airline ticket reservation apparatus (Fig. 1 item 11); and,

data storage apparatus (Fig.1 item 15), comprising: a computer having a hard drive (Spec.: p. 7, line 8), said data storage apparatus being electronically connected to said reservation apparatus (Spec.: p. 7, lines 5-7);

a software program means loaded in said computer for generating agent coupon data simultaneously with generation of an airline ticket (Spec.: p. 7, lines 9-16, 20-22),

transmitting said agent coupon data to said computer (Fig. 1 item 14, Spec.: p.7 lines 9-13, 20-25), storing (Fig. 1 item15, Spec.: p. 8, lines 1-20) and retrieving said agent coupon data (Fig.1 item17, Spec.: p. 9, lines 10-25, p.10 lines 1-10), on memory storage apparatus connected to said computer (Spec.: p.7, lines 8-9); and,

printing means connected to said computer (Fig1 item 18, Spec.: p. 10, lines 2-3) for printing said stored and retrieved agent coupon data in the format of an agent coupon (Fig. 1 item19, Spec.: p. 6-9).

B. Concise Statement Of Examiner's Grounds Of Rejection

In rejecting the claims under 35 U.S.C § 103(a) and responding to Applicant's argument in the request to reopen prosecution, the Examiner stated the grounds of rejection as follows

1. "...although ARC in its entirety seems to suggest an optical storage of image data, an artisan would have found it obvious to also store the image data in electronic form for subsequent reconstruction of the image.", Office Action of May 24, 2005, page 3, lines 8-10.

2.. That because ARC prohibited the use of a hard drive indicated that ARC disclosed and knew of alternative methods for storing agent coupons. Thus, this teaches one of ordinary skill in the art that supporting documents including the agent coupon could be stored on a magnet medium including a hard drive.

C. The Examiner's Ground Of Rejection Under B.1 Above Is Erroneous

1. The Examiner Has Misconstrued Applicant's Invention And ARC's Disclosures In Arriving At The Grounds of Rejection

The Examiner's rejection grounded under "B1" above was that of the appeal board in its prior decision which was and is now based on prior art comprising transmissions over a communications channel such as a facsimile transmission or a multimedia network transmission. The reasoning being that it would be obvious in accordance with this prior art to store the image data in electronic form for later reconstruction of the image. (In the decision of January 25, 2005, the Board overruled the Examiner's basis of rejection under 35 U.S.C. § 102 (f) and under 35 U.S.C. § 103 as based on the Friedes prior art. But then the Board entered a new ground of rejection under 35 U.S.C. § 103 stating that even though ARC does not disclose electronic storage of data as found by the Examiner, ARC discloses the storage of coupon data in optical form. Thus, the Board reasoned that the storage of coupon data electronically would have been obvious to the artisan in view of the teachings in ARC that the coupon data should be stored in optical form. The Board then stated that it was well known in the art to store image data in electronic form so that it could be transmitted over a communications channel such as a facsimile transmission or a multi-media network channel). Thus, the Examiner completely adopted the Board's findings and conclusion in his final rejection under "B.1" above.

With all respect, Applicant submits that the Examiner has misconstrued Applicant's invention and what is being claimed by the Applicant in advancing the new basis of rejection under 35 U.S.C. § 103(a); in addition the Examiner has misinterpreted ARC's disclosures and Applicant's prior appeal arguments. In all probability, the misconstruction in part stemmed from the necessity of Applicant's prior appeal arguments to address the inventorship issues of rejection raised by the Examiner in his first final rejection, which the Board emphatically overruled. In Appellant's Briefs, Applicant quoted the Examiner's stated basis of rejection based on the ARC disclosures and relied on by the Examiner. Applicant's brief also countered the Examiner's basis by quoting ARC's disclosures that contradicted those selected by the Examiner. The Examiner's quoted disclosures and Applicant's quoted disclosures in opposition as stated in Applicant's appeal briefs are incorporated herein by

reference to the extent that the same is necessary. It is therefore submitted by Applicant that the Board's and the Examiner's misconstruction of Applicant's invention stemmed from the necessity to comment and or argument to counter the Examiner's overruled basis of rejection. Fortunately, this appeal concerns only one issue and the arguments made herein will not be affected by any spillover from other issues.

In Applicant's prior appeal arguments, incorporated herein by reference, it was argued that ARC only disclosed the storage of an *image* of the agent coupon and not the electronic storage of *agent coupon data*. However, in its decision, the Board stated:

Appellant responds that when all of the disclosures of ARC are considered as a whole, it is clear that ARC did not contemplate the electronic storage of agent coupon data (reply brief, pages 2-5, 7-11)

We will not sustain the Examiner's rejection of the claims under 35 § 102 (f). **We agree with applicant that ARC, when considered in its entirety, only discloses that agent coupon data should be stored in optical form** The attempt by the Examiner to read electronic storage of coupon data into the ARC disclosure is based on pure speculation.”, (pages 5-6, emphasis supplied).

Applicant did not make the argument (in bold above) which the Board says, that Applicant agreed to (and the Examiner adopted in his rejection in issue), i.e., that ARC only discloses that *agent coupon data* should be stored in *optical form*. As evidenced in Applicants prior appeal, Applicant argued that ARC disclosed the *optical storage of the actual image* of the agent coupon and not the *electronic storage of agent coupon data*. Thus, Applicant's prior appeal argument centered on the distinction between image and data. Notwithstanding the misstatement of Applicant's appeal argument, the Board correctly reversed the Examiner's rejections. However, the misstatement of Applicant's prior appeal arguments which formed the basis of the new ground of rejection by the Board and now adopted by the Examiner, is not supported by the

record. Clearly the only disclosure made by ARC is that the *image* of the agent coupon is to be stored; and, not that the agent coupon *data* should be optically stored. In fact, it was clearly pointed out in the prior appeal that ARC would not approve any system that includes the storage of coupon *data* in any form. ARC insisted that the *image* of the agent coupon had to be optically stored. Thus, the Board, and now the Examiner, have misconstrued Applicant's prior appeal arguments and ARC's disclosures and then used this misconception to arrive at this ground of rejection. There is no support in the record to the misconception of Applicant's arguments and neither the Board nor the Examiner provide such record support.

In furtherance of its decision, the Board later stated "We incorporate the findings made by the Examiner ...except for the finding that ARC discloses the electronic storage of coupon data.", (page 11, lines 8-11). What other findings of the Examiner the Board incorporated in its decision is not spelled out. The Board further stated on page 11, lines 11-16, "Even though we found above that ARC does not disclose the electronic storage of coupon data as asserted by the Examiner [which argument the Applicant did make on appeal] we agree with the Examiner's position that the storage of coupon data electronically would have been obvious to the artisan in view of the teachings of ARC that coupon *data* should be stored in optical form." (emphasis supplied). Thus, while the Board agreed that ARC's disclosures do not in any way teach the electronic storage of coupon data, the Board advanced that ARC's disclosure teaches optical storage of coupon *data*. The Examiner has in his final rejection adopted this argument. This is a completely erroneous statement of the teachings of ARC. As continually argued by Applicant, the only teachings of ARC is to optically store the *image* of the agent coupon.

As noted above in Applicant's briefs, ARC consistently stated, that ARC's disclosure was to store the agent coupon in optical form. Again there are two aspects to ARC's disclosure, i.e., coupon image, and coupon data. Most importantly, Applicant's claimed invention does not involve a method where the image of the agent coupon is generated from the prior art reservation system, nor where optical storage is

used. Claim 1 recites *coupon data* and *electronic storage of the data*. The specific language of these claim limitations is in part critical to a determination of obviousness. The Board and now the Examiner, however, materially deviated from this specific language as follows where it is stated,

...At the time the application was filed, it was well known in the art to store *image data* in electronic form so that it could be transmitted over a communications channel such as a facsimile transmission or a multi-media network channel. Thus, although ARC in its entirety seems to suggest an optical storage of *image data*, the artisan would have found it obvious to also store the *image data* in electronic form for subsequent reconstruction of the image.

In the final rejection of May 24, 2005, the Examiner requoted and adopted the Board's language, above. Based on this statement by the Examiner, Applicant submits that the Examiner erroneously believes that Applicant's invention is the taking of the data from the image of the agent coupon from the prior art reservation system and is applying the factors of obviousness to this step. The claimed invention, as shown in Figure 1, states that agent coupon data is *generated* from the prior art reservation system. If applicant's invention were to simply take the agent coupon image data and store it, the result would be the storage of the agent coupon itself as an image and not data. Thus, the inventive method does not take the data from the image created and printed by prior art reservation system and store it.

Further, ARC never mentioned the words "image data." The combination of the words "image" and "data" is a creation of the Examiner and the Board. Since an image is not data and data is not an image, as the words are commonly used, the meaning of "image data" as used by the Examiner is not clear. The only possible interpretation that Applicant can ascribe to these words are that an image is created and then data is somehow taken from the image. This is not applicant's invention. At the time the data is generated, no image exists. No image is created in applicant's invention until the data stored as data and then configured as an image. Therefore, the Board inappropriately mixed words to arrive at its conclusion, which conclusion was adopted by the Examiner in his second final rejection. It was Applicant who claimed

the limiting words “agent coupon data” in claim 1, not ARC, and not in the mixed manner, i.e. “image data”, now stated by the Examiner. Simply stated, ARC’s goal was to allow elimination of paper copies of the agent coupon but in its place store the optical image of the agent coupon. While on its face this goal is seemingly simple but in actuality it is not because the then reservation system only had the ability to print an agent coupon and not optically store the image. In fact there is still no presently existing method to allow the prior art reservation system to eliminate the printing of an agent coupon or to optically store the image of the agent coupon without first printing the agent coupon.. ARC recognized this inability and that is why it dictated that the image be stored on microfiche film or other optical media. Moreover, in order to store the image of the agent coupon on microfiche or other optical media, the image had to be physically created and then copied onto the film. Alternatively, if the agent coupon was to be optically stored by electronic means as an image, the image had to physically exist in the first place. The only way for the agent coupon to initially exist in accordance with the then agent reservation system was to print the agent coupon and then copy the image and then store it as an image. In other words, ARC simply disclosed that it was acceptable to optically store the image of the coupon in lieu of storing paper copies of the coupon. ARC never disclosed or suggested that it was permissible or possible to store agent coupon data in lieu of storing paper copies of the agent coupon.

A conclusive showing as to what ARC disclosed in 2000 (at the time of the application) and in 2005 (at the present time) is shown in the applicable sections of the 2000 IAH and the 2005 IAH, Exhibits 1 and 2 respectively.

In the 2000 IAH handbook, Section 70.0, (Appendix B)ARC stated:

As an alternative to maintaining supporting documents in paper format, an agent may...maintain the required documents on microfiche/film or on an optical storage medium ...under the following conditions.

(1) The sales reports and all supporting documents must be copied to microfiche/film or to a non-magnetic optical medium that uses a

“write once, read only” technology which will prevent overwriting
....However, computer hard drives, zip drives, floppy disks,
magnetic tape, and other magnetic media are NOT acceptable.
(emphasis in the original)

In the 2005 IAH handbook, Section 70.0, (Appendix B)ARC stated:

As an alternative to maintaining supporting documents in paper format, an agent may...maintain the required documents on microfiche/film or on an optical storage medium ...under the following conditions.

(1) The sales reports and all supporting documents must be copied to microfiche/film or to a non-magnetic optical medium that uses a “write once, read only” technology which will prevent overwriting
....However, computer hard drives, zip drives, floppy disks, magnetic tape, and other magnetic media are NOT acceptable.
(emphasis in the original)

As can be seen, the 2000 and the 2005 handbooks read exactly the same. Thus, without doubt, ARC disclosed and still requires that an agent coupon and other sales and supporting documents be “copied” and then stored. “Copied” necessitates that the document first be in a physical format, in other words printed and then stored optically or otherwise. Data storage by any magnetic media was and is still prohibited. Thus, it cannot be stated that ARC disclosed that agent coupon *data* nor coupon image data should be stored in optical form .

2. The Examiner’s References Under (B 1) Above Do Not Teach Or Suggest Applicant’s Invention

In the second final rejection, the Examiner adopted the Board’s misinterpretation of ARC’s teachings to be the optical storage of *image data*, as well as the Board’s prior art reference of facsimile transmissions as applicable to the issue of obviousness (page 3). In this regard, the Examiner committed clear error. The facsimile reference might be applicable if Applicant had claimed the electronic storage of the *image*. Applicant however has claimed the electronic storage of the generated data. This is a distinction with a difference. As noted above “image data” can only

mean that data is taken from an image, although how this is accomplished is not stated by the Examiner, requires that an image first exist. Contrarily, coupon data involves no image, just data. Applicant submits that the facsimile analogy is therefore misplaced in that the technology involved in facsimile transmission is that of an image broken down to white and black bits of information each of which is transmitted as an image and not data. See Appendix B containing an article entitled "How Fax Machines Work", which article is incorporated herein by reference. For the Board and the Examiner to find that the technology involved in Applicant's claimed invention was the same as a facsimile machine is therefore obviously erroneous.

The Board's and Examiner's other reference to storing "image data" in electronic form and transmitted using a multi-media network is also misplaced. Certainly data can be transmitted within a network and an image can be transmitted within a network. But that also is not Applicant's invention. Applicant's invention generates data but not from an image. Moreover, coupon data that is transmitted in a network cannot be later configured as an image of an agent coupon unless Applicant's invention is used.

As stated above, the words "image data" are confusing and not explained by the Examiner. It is either an image or data, but not both. And, the Examiner nor the Board have explained what is meant by image data being stored in electronic form. It is believed by Applicant that the Examiner and the Board are referring to transmitting data, either as raw data or incorporated in a document, from one computer to another using a network arrangement. If Applicant's understanding is correct, this example cited by the Examiner is again misplaced. Certainly data, raw or in a form, can be sent from one computer to another, but that is not Applicant's invention and concerns only one step of the method claimed by Applicant. The law is clear that a claim can incorporate elements of the prior art in a claim, but the invention as a whole as claimed must be considered in an obviousness issue. Thus, even if the reference to a multimedia network has any validity, nothing in the prior art which the Board or the Examiner have collectively labeled as "ARC" in combination with a multi media

network system suggests or teaches the step of generating the agent coupon data as shown in Figure 1 and stated in Claim 1. The Examiner's argument in support of obviousness does not address the whole of claim 1 and is legally insufficient.

D The Examiner's Second ground Of Rejection under 35 U.S.C. § 103(a) Is Erroneous.

In all fairness, the Examiner attempted to supplement the Boards new ground of rejection by putting forth his own statements in support of the Board's basis. As shown in more detail below, the Examiner's statements in support of his final rejection are of no merit and are self contradictory.

Interestingly, the Examiner argues that because ARC stated that computer hard drives (and other magnetic media) are not acceptable, this discloses that alternate means for storing the supporting documents, including the agent coupon was not only known but considered by ARC and therefore Applicant's invention is obvious. The Examiner is completely misinterpreting ARC's statement and the then known art. In order to properly interpret the statement relied on by the Examiner, the complete IAH statement must be considered as well as other statements by ARC. The introduction to the statement begins with the allowed practice of eliminating paper coupons and "...an agent may...maintain the required documents on microfiche/film or on an optical storage medium ...under the following conditions." The "following condition" prohibits storage of the documents, including the image of the agent coupon, on hard drives and other magnetic media, - not the storage of the data on hard drives. Storage of data is completely prohibited by ARC. Thus, the proper interpretation of the portion relied on by the Examiner concerns prohibiting the copying an *image* of the coupon on a hard drive. Therefore, the image must be created before any storage takes place or is suggested. With the prior art then existing and even today, there is no ability to copy the coupon without first creating an image of the coupon. Thus. ARC stated that after the coupon is produced as a document, it is not permissible to copy the

image to a hard drive. This is not Applicant's invention. It is also to be remembered that ARC stated "If you're using a type of optical storage media, we're talking about capturing the image of the coupon, not creating a database."

A further showing of the Examiner's misinterpretation is the Examiner's contradictory statements is his statement "This citation does not state that an *optical image* of the agent coupon is being *stored*, only that the required *documents* (which would include the agent coupon) may be *stored* on an optical storage medium that cannot be overwritten." (page 4 lines 17-20, referring to the IAH quote by ARC); and, the Examiner's statement on page 3 lines 12-13, "ARC stated ...all supporting *documents* must be *copied* to microfiche/film ..." The words "copied" and "storage" as used by the Examiner are therefore mutually exclusive rendering the Examiner's statements contradictory and not possible to form a basis of rejection under 35 U.S.C. § 103.

E. The Problem Faced And Solved By The Applicant

Realizing the futility and extra effort involved in ARC's suggestions and permissible deviation from storing paper (printed) agent coupons, Applicant believed that there had to be a better solution. Discarding the paper coupon after it was printed and then optically transferred to film or an optical media eliminated one requirement but then created another. The better solution would be to eliminate the paper (printed) coupon altogether. Thus, the problem faced by the Applicant was to eliminate the necessity to first print the agent coupon and then optically store it. As explained above, the task could not be accomplished by ARC's disclosures because of the inherent inconsistency in requiring that the coupon be first printed and then its image be stored as a means to eliminate the physical storage of agent coupons.

Applicant's invention overcame this apparent inconsistent feat by the unique solution disclosed and claimed in the subject application which solution does not involve first printing the coupon and then optically storing it.

The problem faced by the inventor is one factor in determining the issue of obviousness. The problem faced by the Applicant was to achieve ARC's goal of eliminating storage of paper agent coupons, but not by using the method disclosed or suggested by ARC. In order to do this the Applicant invented the method involving the steps of generating agent coupon data simultaneously with the printing of the airline ticket while using the then available agent reservation system, and then storing the coupon data in electronic form and not in optical form.. In the prior art as explained in the specification of the application, the agent coupon was printed along with the printing of the airline ticket. In stead of storing paper (printed) agent coupons, ARC wanted the image stored in an optical media after it was printed, e.g. microfiche. It absolutely did not want the agent coupon data to be stored, see the ARC quotes in the 2000 and 2005 IAH . Accordingly in a direction away from ARC's teaching, the Applicant invented the method of generating agent coupon data using the prior art agent reservation system, as shown in Figure 1 of the drawings, during the time that the airline ticket was being printed. Then the generated coupon data was separated from the prior art reservation system, identified and the data was electronically stored for future printing in the exact form of a prior art agent coupon, all in a manner not previously known or suggested. Applicant's invention therefore achieves the ability to completely eliminate the printing of an agent coupon during the printing of an airline ticket and not storing an optical image of the coupon. Applicant's claimed invention further provides the ability to print an exact copy of the agent coupon at a future time from the stored data and not from a stored image of the coupon. In this regard, Applicant's claimed invention is completely different from ARC's disclosures or any suggestion in ARC's disclosures. See the declaration of Applicant in Appendix B.

F. The Examiner Has Not Make A Showing Of A Prima Facie Case Of Obviousness

While Applicant agrees in general with the law cited by the Board and adopted by the Examiner, regarding a prima facie case of obviousness, it is submitted that the Examiner has failed to show a prima facie case of obviousness in accordance with the cited law. In the absence of a showing of a prima facie case of obviousness, an applicant is entitled to a patent, In re Rouffet, 149 F.3d 1350 (CAFC 1998). A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art. The constituent factual findings for a prima facie case of obviousness are: 1) the scope and content of the prior art; 2) the level of ordinary skill in the art; 3) the differences between the prior art and the claimed invention, In re Greene, 1999 U.S. App Lexis 32002 (CAFC 1999).

In re Fine 837 F.2d 1071 (CAFC 1988) is another case applicable to the lack of showing of a prima facie case of obviousness by the Examiner. There the court reversed the Board's showing of prima facie case of obviousness. The court stated that the burden can only be satisfied by showing some objective teaching in the prior art or knowledge that is generally available to one of ordinary skill would lead that individual to combine the references. Then the court noted that both the Board and the Examiner baldly stated that the substitution was within the skill of the art but pointed to nothing suggesting the combination or provided support for the bald assertion.

It is well known that a ticket reservation system includes a main frame, a computer and a printer. It is also well known that the prior art ticket reservation system prints an airline ticket and prints an agent coupon. ARC's disclosures permits the travel agent to optically store the agent coupon which can only be done after the agent coupon is printed and then allows the travel agent to discard the printed or paper copy of the agent coupon. As noted above, Applicant realized that ARC's disclosure or permission was in reality of little benefit to a travel agent. While eliminating the necessity to physically store paper agent coupons, it required the images to be scanned and then stored. Arc's disclosures did not suggest or teach the elimination of an image of the agent coupon, but rather that the paper copy of the coupon can be

discarded after its image is stored. Accordingly, Applicant sought to devise a method that both eliminated the need to store paper agent coupons and eliminated the need to print an agent coupon and then optically scan it and store the image. Applicant's claimed invention accomplishes these objectives. In the specification, on page 4 lines 10-12, it is stated that the inventive method includes the data being obtained directly from the reservation system as shown in Figure 1. In other words, the coupon data is generated from the information stream from the reservation system, and since the reservation system, in the inventive method, does not print the agent coupon, the coupon data is generated from the reservation system flow of information. Claim 1 includes the limitation "generating agent coupon data simultaneously with the printing of an airline ticket". Figure 1 shows that the agent coupon data (13) is taken from the ticket reservation system (11). Inasmuch as ARC's disclosures in combination with the technology of a facsimile machine transmission and/or in combination with a multi media network transmission does not result in Applicant's claimed invention, a prima facie case of obviousness has not been shown by the Examiner is adopting the Board's new basis of rejection.

In re Lee 277 F. 3d 1338, (Fed. Cir. 2002), is yet another case applicable to the lack of showing of a prima facie case of obviousness by the Board. The In re Lee court held that the factual inquiry whether to combine references must be thorough and searching and that it must be based on objective evidence of record. The court further held that: the agency must articulate a satisfactory explanation for its action including a rational connection between the facts found and the choice made; omission of a relevant factor required by precedent is both legal error and arbitrary agency action; reasoned findings are critical to agency performance and judicial reliance on agency competency; general conclusions about what is common knowledge or common sense are not sufficient to support agency findings; common knowledge and common sense, even if assumed to derive from the agency's expertise, do not substitute for authority when the law requires authority. With regard to the above holdings, the Court stated:

The need for specificity pervades this authority. See, e.g., In re Kotzab, 217 F.3d 1365, (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); In re Rouffet, 149 F. 3d 1350, 1359, (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. "); In re Fritch, 972 F. 2d 1260, (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").

In re Dembicazk, 175 F.3d 994 (Fed. Cir. 1999) the court also stated that the best defense against the subtle but powerful attraction of hindsight based obviousness is a rigorous application of the requirement for showing of the teaching or motivation to combine the prior art references. Here, the Examiner made no such rigorous showing of the teaching or motivation to combine the references cited. Rather the Examiner merely advanced a conclusory statement that because facsimile technology and multi media networking technology was well known to store "image data", it would be obvious to store "image data" in electronic form for subsequent reconstruction as an image. Again the meaning of "image data" is critical. Does it mean an image or data? If it means an image, that is not Applicant's invention. If it means data, the prior art does not generate data –it generates an image. Arc's disclosures do not suggest storage of "image data"; ARC never used the words "image data". ARC only suggested storage of the image of the agent coupon. Therefore, it does not logically or legally follow that it would have been obvious to store the "image data" for subsequent reconstruction of the image.

In In re Lee the Board and Examiner baldly made a statement that no hint of suggestion is needed where common knowledge and common sense are involved. In the present case an equally bald statement is made by the Examiner in advancing his finding of obviousness. The Examiner stated “thus, although ARC in its entirety seems to suggest an optical storage of image data, ...” As noted above, ARC never disclosed or stated the mutually exclusive words “image data”. More importantly, the Examiner baldly used the word “seems” with regard to what ARC suggests. In accordance with In re Lee, the word “seems” has no specificity to indicate what ARC suggests, especially where ARC never used the words “image data”. Without specificity it is not possible for specific findings to exist. Indeed, the Examiner has not in accordance with In re Lee explained how one of ordinary skill in the art would have been motivated to select the references and to combine them, or would have selected these components for combination in the manner claimed to render the claimed invention obvious.

Here, the Examiner cited the art of facsimile machines and multi media networking as prior art which in combination with ARC’s disclosures renders Applicant’s invention obvious. Notwithstanding that the Examiner has misinterpreted and misconstrued ARC’s disclosures and Applicant’s invention, as explained above, the Examiner has not explained how the technology involved in that art functions to render Applicant’s invention obvious as required by In re Lee. Then too, as Applicant explained herein, the operation of the facsimile transmission is different from Applicant’s claimed method and the multi media citation at best only concerns the data transmission step of Applicant’s claimed method. Thus, the Examiner’s finding does not consider Applicant’s invention as a whole and runs afoul of this well accepted principle of law.

The Examiner’s finding makes no attempt define the level of ordinary skill in the art of the invention as required by Graham v. John Deere, 383, U.S. 1 (1966) and In re Greene, supra. This lack of determination is sufficient in and of itself to render the Examiner’s finding clearly erroneous.

Accordingly, the Examiner's findings do not comply with the required factual findings for a prima facie case of obviousness. That is, the Examiner has not determined the scope and content of the prior art; the level of ordinary skill in the art; or, the differences between the prior art and the claimed invention, Graham v. John Deere; In re Greene, supra.

G. Applicant's Further Rebuttal To The Examiner's Finding Of Obviousness

Notwithstanding that Applicant does not agree that the Examiner has made a showing of a prima facie case of obviousness, the following rebuttal is submitted. 35 U.S. § 103 is the ultimate controlling authority as interpreted by the Federal Circuit for the issue of obviousness, which in effect states that a person cannot obtain a patent if the subject matter of the invention is considered obvious to a person of ordinary skill in the art to which the invention pertains, Graham v. John Deere, supra. In assessing the issue of obviousness the factors to be considered are: 1) the scope and content of the prior art; 2) the level of ordinary skill in the art; 3) the differences between the prior art and the claimed invention, Id.

The prior art as stated by the Examiner are the ARC disclosures, the facsimile machine and a multimedia networking arrangement. As noted above, Applicant's position of the ARC disclosures is that paper agent coupons can be eliminated provided that an image of the agent coupon is optically stored. The Examiner's interpretation of the ARC disclosures is that optical storage of an agent coupon "image data" should be stored. With regard to these different interpretations of what the ARC disclosures teach or suggest, Applicant incorporates herein all of the above statements and arguments pertaining to this factor. Accordingly, Applicant submits that the Examiner's interpretation is unwarranted and not supported by the record. On the other hand, Applicant's interpretation of the scope and content of the ARC disclosures are as stated in the IAH handbook published at the time of the application as well as all of the statements made by ARC with regard thereto

"If you're using a type of optical storage media, we're talking about capturing the image of the coupon, not creating a database."

Allan Muten, ARC corporate communications director, as reported in the Travel Weekly News dated 6/20/2000 (doc. AM, Form PTO 1449)

Applicant submits that the above single quote by ARC and the consistent IAH statements of 200 and 2005, firmly put to rest any question of the interpretation of the ARC disclosures. Nothing could be more clear. Applicant's interpretation is correct, the Examiner's is erroneous. In view of the only supportable interpretation of the ARC disclosures, the facsimile and multi media networking references cited by the Examiner are totally inapplicable or at the very best apply to one step of the Applicant's claimed invention, as explained above. In either event, the combination of the references do not teach or suggest Applicant's claimed invention; or in the alternative do not address Applicant's invention as a whole. Accordingly, the Applicant has rebutted the Examiner's determination of the scope and content of the prior art. Applicant has also shown that the differences between the prior art and the claimed invention do not support a finding of obviousness, see the above. (Applicant still maintains that the Examiner has not shown any authority to support a different conclusion, as explained above).

In his decision, the Examiner has not made any attempt to determine the factor regarding the level of ordinary skill in the art. Exhibit 4, attached to Applicant's request to reopen prosecution, is a declaration of the Applicant that shows the history of his invention and that his level of skill in the art is superior to one of ordinary skill

The copies of the pertinent portion of the 2005 IAH (Exhibit 2) reveals that ARC is still disclosing the need to optically capture the image of the agent coupon as did the 2000 IAH (Exhibit 1) at the time of the application. Thus, it is shown that ARC and others, other than Applicant, have failed to make Applicant's invention for over 5 years based on ARC's disclosures. Even if the level of skill in the art is considered high, the failure of others to make Applicant's invention for at least 5 years based on ARC's disclosures evidences that a person of ordinary skill has not considered Applicant's invention obvious. That Applicant's invention has satisfied a

long felt need is also shown by the years apart statements by ARC regarding the same optical storage of the image of the agent coupon disclosures by ARC.

Accordingly, a full and supportable determination of the Graham V. John Deere factors, as advanced herein leads to the only conclusion that Applicant's invention when taken as a whole, without the prohibited use of hindsight, was not obvious to a person of ordinary skill in the art to which the invention pertains, at the time of the application.

Rebuttal evidence is merely a showing of facts supporting the opposite conclusion and may relate to the Graham factors including the secondary considerations, In re Plasecki, 745 F. 2d 1468 (Fed. Cir 1984). If rebuttal evidence of adequate weight is produced. The holding of a prima facie case of obviousness is dissipated. Moreover, the Examiner must consider all of the evidence anew regardless of the strength or weakness of the prima facie case, *id.* In accordance with the above submitted evidence, Applicants submits that the showing, if any, of a prima facie case of obviousness is dissipated.

H. The ARC Disclosures Teach Away From Applicant's Claimed Invention

In the prior art as explained in the specification of the application, the agent coupon was printed along with the printing of the airline ticket. In stead of printing and storing paper agent coupons, ARC wanted the image stored in an optical media, e.g. microfiche. It absolutely did not want the agent coupon data to be stored, see the ARC Industrial Agents' Handbook quoted above, Exhibits 1 and 2, respectively. Accordingly in a direction away from ARC's teaching, the Applicant invented the method of generating agent coupon data by extracting the data from the prior art agent reservation system, as shown in Figure 1 of the drawings, during the time that the airline ticket was being printed. Then the generated coupon data was separated from the prior art reservation system, identified and the data was electronically stored for future printing in the exact form of a prior art agent coupon, all in a manner not previously known or suggested. Applicant's invention therefore achieves the ability to

completely eliminate the printing of an agent coupon during the printing of an airline ticket and not storing an optical image of the coupon. Applicant's claimed invention further provides the ability to print an exact copy of the agent coupon at a future time from the stored data and not from a stored image of the coupon. In this regard, Applicant's claimed invention is completely different and away from ARC's disclosures or any suggestion in ARC's disclosures.

Moreover, as explained above, the Examiner's reference to Facsimile transmission is inapplicable in that said technology transmits an image and not data. The Board's reference to multi media networking also falls short of showing obviousness in that it may refer or be applicable to but one step in Applicant's claimed invention and not the invention as a whole.

With regard to an issue of obviousness a reference that teaches away is a significant factor to be considered in determining obviousness. A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant. In general, a reference will teach away if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the relief sought by the applicant. In re Gurley, 27 F. 3d 551 (Fed. Cir. 1994). Applicant submits that it is inconceivable to find that or reach any conclusion other than the 2000 and the 2005 IAH handbooks teach away from the path taken by Applicant. The path taken by applicant completely eliminates the need to print and then optically store the image of an agent coupon. ARC's disclosures do not render Applicant's claimed invention obvious.

I. The Examiner's Response To Applicant's Above Arguments Are Void Of Any Substance.

In responding to Applicant's above arguments presented in the request to reopen the prosecution, the Examiner merely stated that the same were not persuasive. However, in an attempt to actually respond to Applicant's arguments regarding the important distinction between storing an image versus storing data, the Examiner

confusingly responded that the requirement to “maintain the required documents on microfiche/film or on an optical storage medium....which will prevent overwriting” “... does not state that an optical image is being stored, only that the required documents may be stored on an optical storage medium that cannot be overwritten.” It is respectfully submitted that the Examiner’s response is not only confusing but not responsive to the factual argument as to what ARC disclosed regarding an image vis-a-vis data. Moreover, the compact disc definition presented by the Examiner is also irrelevant to the distinction between storage of data and the storage of an image.

An even more confusing attempt by the Examiner to respond to Applicant’s argument regarding Applicant’s claimed the use of a hard drive is directly contrary to ARC prohibition of the use of the same (because it can be overwritten). Some how, the Examiner uses the fact that the ARC’s prohibition is a suggestion to use a hard drive. Such reasoning is incomprehensible but probably due to the Examiner’s continuous refusal to accept the distinction between an image and data in the references and Applicant’s claimed invention.

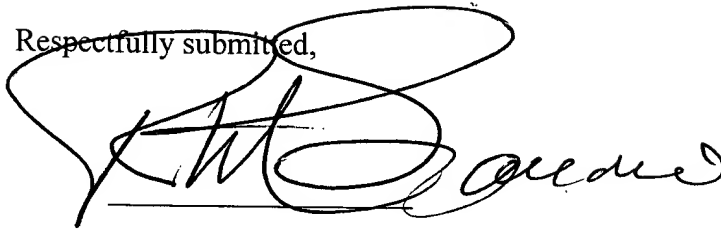
9. Appendixes A, B, and C are attached.

CONCLUSION

The Examiner has not shown a prima facie case of obviousness in his rejection; or in the alternative, and assuming without conceding that he has, Applicant has authoritatively, sufficiently and adequately rebutted the finding of obviousness. Applicant respectfully requests that Board overrule the Examiner’s present 35 U.S.C. § 103(a) rejection and allow the application in its present form.

Dated September 21, 2005.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "R. M. Saccocio", written over a horizontal line.

Richard M. Saccocio
Attorney For Applicant
Registration No. 26,8000

In re The Application Of:



INVENTOR(S): Rodger Burrows

GROUP ART UNIT: 3622

SERIAL No.: 09/910,654

EXAMINER: Myhre, James W.

FILING DATE: 7/20/01

TITLE: METHODS AND APPARATUS FOR ELECTRONICALLY STORING
TRAVEL AGENT COUPONS

APPENDIX A
35 CFR § 41.37(c)(1)(viii)

CLAIMS ON APPEAL

1. A method for electronically generating, storing, and retrieving airline ticket agency coupon data, comprising the steps of:

generating agent coupon data simultaneously with the printing of an airline ticket;

transmitting and storing said agent coupon data electronically to and in data storage apparatus;

providing each agent coupon data with an identifier;

storing said agent coupon data in a director/directory/image file arrangement; and

retrieving said electronically stored agent coupon data and printing the same in the format of an agent coupon.

2. The method of claim 1, including the step of storing said agent coupon data on a compact disk.
3. The method of claim 1, including the step of storing said agent coupon data on a hard drive.
4. The method of claim 1, including the step of transmitting and storing a plurality of agent coupon data in a batch file format.
5. The method of claim 1, including the step of generating said agent coupon data by airline ticket reservation apparatus.
6. The method of claim 5, including the step of serially connecting said reservation apparatus to said data storage apparatus.
7. The method of claim 5, including the step of connecting said reservation apparatus to said data storage apparatus by a modem.
8. The method of claim 5, including the step of internet connecting said reservation apparatus to said data storage apparatus.

9. The method of claim 5, including the step of intranet connecting said reservation apparatus to said data storage apparatus.
10. The method of claim 1, wherein said identifier comprises an ARC number.
11. The method of claim 10, wherein said identifier includes a sales period ending date.
12. The method of claim 11, wherein said identifier includes a ticket number.
13. The method of claim 12, wherein said identifier includes a passenger's name.
14. The method of claim 13, wherein said identifier includes a record locator.
15. Apparatus adapted to generate, transmit, store and retrieve airline agent coupon data, comprising:
 - airline ticket reservation apparatus; and,
 - data storage apparatus comprising :a computer having a hard drive, said data storage apparatus being electronically connected to said reservation apparatus ;a software program means loaded in said computer for generating agent coupon data simultaneously with generation of an airline ticket, transmitting said agent coupon data to said computer, storing and retrieving said agent coupon data, on memory

storage apparatus connected to said computer; and printing means connected to said computer for printing said stored and retrieved agent coupon data in the format of an agent coupon.

17. The apparatus of claim 15, wherein said software program means further includes means for identifying each generated agent coupon data.
18. The apparatus of claim 17, wherein said software program means further includes means for filing each generated agent coupon data in accordance with said identifier means.

In re The Application Of:

INVENTOR(S): Rodger Burrow

GROUP ART UNIT: 3622

SERIAL No.: 09/910,654

EXAMINER: Myhre, James W.

FILING DATE: 7/20/01

TITLE: METHODS AND APPARATUS FOR ELECTRONICALLY STORING
TRAVEL AGENT COUPONS

APPENDIX B

37 CFR § 41.37(c)(1)(ix)

EVIDENCE APPENDIX

Pursuant to 37 CFR § 41.37(c)(1)(ix), Applicant submits this Appendix of evidence entered by the Examiner and relied on by Applicant in this appeal.

The evidence consists of:

Ex. 1: 2000 IAH Section 70.0.

Ex. 2: 2005 IAH Section 70.0.

Ex. 3: "How Fax Machines Work", 3/24/05.

Ex. 4: Declaration of Applicant, dated 3-25-05

Request To Reopen Prosecution, mailed 3/25/05

Office Action Mailed on May 24, 2005

The above evidence was submitted to the Examiner on March 25, 2005 and entered by the Examiner in the Office Action dated May 24, 2005. The evidence relied on

by the Examiner as grounds of rejection to be reviewed on appeal consists of the Office Action mailed on May 25, 2005. Copies of the above evidence are attached hereto.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS

In re: The Application of:

INVENTOR(S): Rodger Burrows

GROUP ART UNIT: 3622

SERIAL No.: 09/910,654

EXAMINER: Myhre, James W.

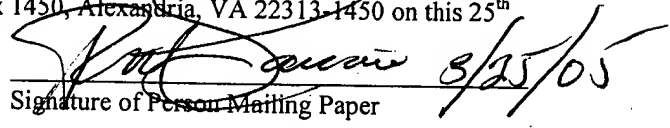
Appeal No. 2004-2110

FILING DATE: 7/20/01

TITLE: METHODS AND APPARATUS FOR ELECTRONICALLY STORING
TRAVEL AGENT COUPONS

CERTIFICATE OF MAILING

I HEREBY CERTIFY that this paper is being mailed, via U.S. Post Office Express mail No. EV 245100273, to Mail Stop: Board of Patent Appeals, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450 on this 25th day of March, 2005.


Signature of Person Mailing Paper

Richard M. Saccocio

Printed Name of Person Mailing Paper

Board Of Patent Appeals
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

TRANSMITTAL LETTER

Transmitted herewith for filing in the above referenced application and appeal are:

Applicant Rodger Burrows Request to Reopen Prosecution
together with Exhibits 1, 2, 3, and 4, in triplicate.

Post card

The Commissioner is hereby authorized to charge any fees to Deposit Account No. 19-0010.


Richard M. Saccocio

Reg. No. 26,800

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IN THE UNITED STATES PATENT OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex Parte Rodger Burrows

Appeal No. 2004-2110
Application No. 09/910,654

SNE22007542A3

REQUEST TO REOPEN PROSECUTION

In response to the Board's decision of January 25, 2005 and in accordance with 37 CFR § 41.50(b) (1), Applicant hereby request to reopen prosecution and submits this paper containing new evidence relating to the claims rejected

REMARKS AND NEW EVIDENCE

THE BOARD MISCONSTRUED APPLICANT'S INVENTION

In the decision of January 25, 2005, the Board overruled the Examiner's basis of rejection under 35 U.S.C. § 102 (f) and under 35 U.S.C. § 103 as based on the Friedes prior art. But then the Board entered a new ground of rejection under 35 U.S.C. § 103 stating that even though ARC does not disclose electronic storage of data as found by the Examiner, ARC discloses the storage of coupon data in optical form. Thus, the storage of coupon data electronically would have been obvious to the artisan in view of the teachings in ARC that the coupon data should be stored in optical form. The Board then stated that it was well known in the art to store image data in electronic form so that it could be transmitted over a communications channel such as a facsimile transmission or a multi-media network channel.

With all respect, it is submitted that the Appeal board has misconstrued Applicant's invention and what is being claimed by the Applicant in advancing the new basis of rejection under 35 U.S.C. § 103; in addition The Board has

misinterpreted ARC's disclosure and Applicant's appeal arguments. In all probability, the misconstruction in part stemmed from the necessity of Applicant's appeal brief and reply brief to address the issues of rejection raised by the Examiner, i.e. the Examiner's rejection insisting that ARC was the inventor in advancing the storage of coupon data and not an optical image; and of course the Friedes reference. Both of which the Board emphatically overruled. In Appellant's Briefs, Applicant quoted the Examiner's stated basis of rejection based on the ARC disclosures and relied on by the Examiner. Applicant's brief also countered the Examiner's basis by quoting ARC's disclosures that contradicted those selected by the Examiner. The Examiner's quoted disclosures and Applicant's quoted disclosures in opposition as stated in Applicant's appeal briefs are incorporated herein by reference.

THE BOARD HAS MISCONSTRUED THE TEACHINGS OF THE PRIOR ART AND APPLICANT'S APPEAL ARGUMENT

In Applicant's appeal arguments, incorporated herein by reference, it was clearly and emphatically argued that ARC only disclosed the storage of an optical image of the agent coupon and not the electronic storage of agent coupon data. In its decision, the Board stated

Appellant responds that when all of the disclosures of ARC are considered as a whole, it is clear that ARC did not contemplate the electronic storage of agent coupon data (reply brief, pages 2-5, 7-11)

We will not sustain the Examiner's rejection of the claims under 35 § 102 (f). We agree with applicant that ARC, when considered in its entirety, only discloses that agent coupon data should be stored in optical form. The attempt by the Examiner to read electronic storage of coupon data into the ARC disclosure is based on pure speculation.",
(pages 5-6, emphasis supplied).

Applicant did not make the argument which the Board says it agrees to, i.e., that ARC only discloses that agent coupon data should be stored in optical form. As evidenced in Applicants brief and reply brief, Applicant argued that ARC disclosed the optical storage of the actual image of the agent coupon and not the electronic

storage of agent coupon data. Thus, Applicant's appeal argument centered on the distinction between two aspects: image and data; and, optical and electronic. Notwithstanding the misstatement of Applicant's appeal argument, the Board correctly reversed the Examiner's rejections. However, the misstatement of Applicant's appeal arguments which forms the basis of the new ground of rejection by the Board is not supported by the record. Clearly the only disclosure made by ARC is that the optical image of the agent coupon is to be stored; and, not that the agent coupon data should be optically stored. The Board has taken an unwarranted interpretation of Applicant's appeal arguments and ARC's disclosures and then used this unwarranted interpretations to arrive at its new ground of rejection. There is no support in the record to the Board's unwarranted interpretations and the Board does not attempt to provide such record support.

In furtherance of its decision, the Board later stated "We incorporate the findings made by the Examiner ...except for the finding that ARC discloses the electronic storage of coupon data." (page 11, lines 8-11) What other findings of the Examiner the Board incorporated in its decision is not spelled out. The Board further stated on page 11, lines 11-16, "Even though we found above that ARC does not disclose the electronic storage of coupon data as asserted by the Examiner [which argument the Applicant did make on appeal] we agree with the Examiner's position that the storage of coupon data electronically would have been obvious to the artisan in view of the teachings of ARC that coupon data should be stored in optical form." (emphasis supplied) Thus, while the Board agrees that ARC's disclosures do not in any way teach the electronic storage of coupon data, the Board advances that ARC's disclosure teaches optical storage of coupon data. This is a completely erroneous statement of the teachings of ARC. As argued in Applicant's appeal, the only teachings of ARC is to optically store the image of the agent coupon.

As noted above in Applicant's briefs, ARC consistently stated, that ARC's disclosure was to store the agent coupon in optical form. Again there are two aspects to ARC's disclosure, i.e., coupon image, and optical storage. Most importantly, Applicant's claimed invention does not involve a method where the image of the

agent coupon is generated from the prior art reservation system, nor where optical storage is used. Claim 1 recites coupon data and electronic storage of the data. The specific language of these claim limitations is in part critical to a determination of obviousness. The Board however, materially deviates from this specific language as follows where it stated,

...At the time the application was filed, it was well known in the art to store image data in electronic form so that it could be transmitted over a communications channel such as a facsimile transmission or a multi-media network channel. Thus, although ARC in its entirety seems to suggest an optical storage of image data, the artisan would have found it obvious to also store the image data in electronic form for subsequent reconstruction of the image.(Emphasis supplied), (page 11, lines 16- 21, page 12, lines 1-2)

Based on this statement by the Board, Applicant submits that the Board and the Examiner erroneously believe that Applicant's invention is the taking of a coupon image from the prior art reservation system and is applying the factors of obviousness to this step. The claimed invention, as shown in Figure 1, states that agent coupon data is generated from the prior art reservation system. Thus, the inventive method does not take an image from the prior art reservation system and store it.

Further, ARC never mentioned the words "image data." Therefore, the Board is inappropriately mixing words to arrive at its conclusion. It was Applicant who claimed the limiting words agent coupon data in claim 1, not ARC and not in the mixed manner stated by the Board. Simply stated, ARC's goal was to allow elimination of paper copies of the agent coupon but in its place store the optical image of the agent coupon. While on its face this goal is seemingly simple but in actuality it is not because unless an image exists it cannot be electronically stored as an image. The only way for the agent coupon to initially exist in accordance with the then agent reservation system was to print the agent coupon and then optically scan it. But this would be counter productive to ARC's disclosures and would require more from the travel agent than just storing the printed coupon. Yet, ARC wanted the image stored in an optical media, e.g. microfiche. It absolutely did not want the agent coupon data to be stored.

A conclusive showing as to what ARC disclosed in 2000 (at the time of the application) and in 2005 (at the present time) is shown in the applicable sections of the 2000 IAH and the 2005 IAH, Exhibits 1 and 2 respectively.

In the 2000 IAH handbook, Section 70.0, (Exhibit 1)ARC stated,

As an alternative to maintaining supporting documents in paper format, an agent may...maintain the required documents on microfiche/film or on an optical storage medium ...under the following conditions.

(1) The sales reports and all supporting documents must be copied to microfiche/film or to a non-magnetic optical medium that uses a "write once, read only" technology which will prevent overwritingHowever, computer hard drives, zip drives, floppy disks, magnetic tape, and other magnetic media are NOT acceptable.
(emphasis in the original)

In the 2005 IAH handbook, Section 70.0, (Exhibit 2)ARC stated,
As an alternative to maintaining supporting documents in paper format, an agent may...maintain the required documents on microfiche/film or on an optical storage medium ...under the following conditions.

(1) The sales reports and all supporting documents must be copied to microfiche/film or to a non-magnetic optical medium that uses a "write once, read only" technology which will prevent overwritingHowever, computer hard drives, zip drives, floppy disks, magnetic tape, and other magnetic media are NOT acceptable.
(emphasis in the original)

As can be seen, the 2000 and the 2005 handbooks read exactly the same. Thus, without doubt, ARC disclosed optical storage of the agent coupon—not electronic storage of agent coupon data, and not optical storage of the coupon image data. Data storage by any magnetic media was and is still prohibited.

THE PROBLEM FACED AND SOLVED BY THE APPLICANT

Realizing the futility and extra effort involved in ARC's disclosures, Applicant considered the ultimate objective to eliminate the necessity to print and store paper copies of the agent coupons and faced the problem of how to do so in a manner different from that suggested by ARC. Thus, the problem faced by the Applicant was

to eliminate the necessity to first print the agent coupon and then optically store it. Applicant's invention overcame this apparent inconsistent feat by the unique solution disclosed and claimed in the subject application which solution does not involve first printing the coupon and then optically storing it.

The problem faced by the inventor is one factor in determining the issue of obviousness. The problem faced by the Applicant was to achieve ARC's goal but not by using the method disclosed or suggested by ARC. In order to do this the Applicant invented the method involving the steps of generating agent coupon data simultaneously with the printing of the airline ticket while using the then available agent reservation system, and then storing the coupon data in electronic form and not in optical form.. In the prior art as explained in the specification of the application, the agent coupon was printed along with the printing of the airline ticket. In stead of printing and storing paper agent coupons, ARC wanted the image stored in an optical media, e.g. microfiche. It absolutely did not want the agent coupon data to be stored, see the ARC quotes in Applicant's appeal arguments . Accordingly in a direction away from ARC's teaching, the Applicant invented the method of generating agent coupon data by extracting the data from the prior art agent reservation system, as shown in Figure 1 of the drawings, during the time that the airline ticket was being printed. Then the generated coupon data was separated from the prior art reservation system, identified and the data was electronically stored for future printing in the exact form of a prior art agent coupon, all in a manner not previously known or suggested. Applicant's invention therefore achieves the ability to completely eliminate the printing of an agent coupon during the printing of an airline ticket and not storing an optical image of the coupon. Applicant's claimed invention further provides the ability to print an exact copy of the agent coupon at a future time from the stored data and not from a stored image of the coupon. In this regard, Applicant's claimed invention is completely different from ARC's disclosures or any suggestion in ARC's disclosures.

THE BOARD'S REFERENCES DO NOT TEACH APPLICANT'S INVENTION

Because the Board has misinterpreted ARC's teachings to be the optical storage of coupon data, it advanced that the prior art technology in facsimile transmissions is a prior art reference applicable to the issue of obviousness. In this regard, the Board has committed clear error. The facsimile reference might be applicable if Applicant had claimed the electronic storage of the image data as the Board mischaracterized ARC's disclosures. Applicant however has claimed the electronic storage of the coupon data. This is a distinction with a difference.. Applicant submits that the facsimile analogy is misplaced in that the technology involved in facsimile transmission is that of an image broken down to white and black bits of information each of which is transmitted as an image and not data. See attached Exhibit 3 being an article entitled "How Fax Machines Work", which exhibit is incorporated herein by reference. For the Board to find that the technology involved in Applicant's claimed invention was the same as a facsimile machine is therefore obviously erroneous.

The Board's other reference to storing image data in electronic form and transmitted using a multi-media network is not fully understood by the Applicant. The words "image data" are mutually exclusive. It is either an image or data, but not both. Moreover, the Board has not explained what is meant by image data being stored in electronic form. It is believed by Applicant that the Board is referring to transmitting data, either as raw data or incorporated in a document, from one computer to another using a network arrangement. If Applicant's understanding is correct, this example cited by the Board is also misplaced. Certainly data, raw or in a form, can be sent from one computer to another, but that is not the whole of the method claimed by Applicant. It is only one step of the method and the law is clear that a claim can incorporate elements of the prior art in a claim, but the invention as a whole as claimed must be considered in an obviousness issue. Nothing in the prior art which the Board has collectively labeled as "ARC" in combination with a multi media

network system suggests or teaches the step of generating the agent coupon data as shown in Figure 1 and stated in Claim 1. Thus, the Board's argument of obviousness does not address the whole of claim 1 and is legally insufficient.

THE BOARD HAS NOT MAKE A SHOWING OF A PRIMA FACIE CASE OF OBVIOUSNESS

While Applicant agrees in general with the law cited by the Board regarding a prima facie case of obviousness, it is submitted that the Board has failed to show a prima facie case of obviousness in accordance with the cited law. In the absence of a showing of a prima facie case of obviousness, an applicant is entitled to a patent, In re Rouffet, 149 F.3d 1350 (CAFC 1998). A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art. The constituent factual findings for a prima facie case of obviousness are: 1) the scope and content of the prior art; 2) the level of ordinary skill in the art; 3) the differences between the prior art and the claimed invention, In re Greene, 1999 U.S. App Lexis 32002 (CAFC 1999).

In re Fine 837 F.2d 1071 (CAFC 1988) is another case applicable to the lack of showing of a prima facie case of obviousness by the Board. There the court reversed the Board's showing of prima facie case of obviousness. The court stated that the burden can only be satisfied by showing some objective teaching in the prior art or knowledge that is generally available to one of ordinary skill would lead that individual to combine the references. Then the court noted that both the Board and the Examiner baldly stated that the substitution was within the skill of the art but pointed to nothing suggesting the combination or provided support for the bald assertion.

It is well known that a ticket reservation system includes a main frame, a computer and a printer. It is also well known that the prior art ticket reservation system prints an airline ticket and then print an agent coupon. ARC's disclosures permits the travel agent to optically store the agent coupon which can only be done

after the agent coupon is printed and then allows the travel agent to discard the printed or paper copy of the agent coupon. As noted above, Applicant realized that ARC's disclosure or permission was in reality of little benefit to a travel agent. While eliminating the necessity to physically store paper agent coupons, it required the images to be scanned and then stored. Accordingly, Applicant sought to devise a method that both eliminated the need to store paper agent coupons and eliminated the need to print an agent coupon and then optically scan it and store the image.

Applicant's claimed invention accomplishes these goals. In the specification, on page 4 lines 10-12, it is stated that the inventive method includes the data being obtained directly from the reservation system as shown in Figure 1. In other words, the coupon data is generated from the information stream from the reservation system, and since the reservation system, in the inventive method, does not print the agent coupon, the coupon data is generated from the reservation system flow of information. Claim 1 includes the limitation "generating agent coupon data simultaneously with the printing of an airline ticket". Figure 1 shows that the agent coupon data (13) is taken from the ticket reservation system (11). Inasmuch as ARC's disclosures in combination with the technology of a facsimile machine transmission and/or in combination with a multi media network transmission does not result in Applicant's claimed invention, a prima facie case of obviousness has not been shown by the Board's new basis of rejection.

In re Lee 277 F.3d 1338, (CAFC 2002), is yet another case applicable to the lack of showing of a prima facie case of obviousness by the Board. The In re Lee court held that the factual inquiry whether to combine references must be thorough and searching and that it must be based on objective evidence of record. The court further held that: the agency must articulate a satisfactory explanation for its action including a rational connection between the facts found and the choice made; omission of a relevant factor required by precedent is both legal error and arbitrary agency action; reasoned findings are critical to agency performance and judicial reliance on agency competency; general conclusions about what is common knowledge or common sense are not sufficient to support agency findings; common knowledge and common sense, even if assumed to derive from the agency's expertise,

do not substitute for authority when the law requires authority. With regard to the above holdings, the Court stated:

The need for specificity pervades this authority. See, e.g., In re Kotzab, 217 F.3d 1365, (Fed. Cir.2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); In re Rouffet, 149 F.3d 1350, 1359, (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. "); In re Fritch, 972 F.2d 1260, (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").

In re Dembicazk, 175 F.3d 994 (CAFC 1999) the court also stated that the best defense against the subtle but powerful attraction of hindsight based obviousness is a rigorous application of the requirement for showing of the teaching or motivation to combine the prior art references. Here, the Board made no such rigorous showing of the teaching or motivation to combine the references cited. Rather the Board merely advanced a conclusory statement that the facsimile technology and the multi media networking technology was well known to store image data it would be obvious to store and transmit optical image data. Moreover, as a prelude to doing so, the Board made the non supported leap going from storage of an image to storage of image data in order to reach the stated conclusory statement..

In In re Lee the Board and Examiner baldly made a statement that no hint of suggestion is needed where common knowledge and common sense are involved. In the present case an equally bald statement is made by the Board in advancing its decision on obviousness. In its decision herein, the Board stated "thus, although ARC

in its entirety seems to suggest an optical storage of image data, the artisan would have found it obvious to also store the image data in electronic form..." (page 11, lines 20-21, page 12, lines 1-2) As noted above, ARC never disclosed or stated the mutually exclusive words "image data". More importantly, the Board baldly used the word "seems" with regard to what ARC suggests. In accordance with In re Lee, the word "seems" has no specificity to indicate what ARC suggests. Without specificity it is not possible for specific findings to exist. Indeed, the Board has not in accordance with In re Lee explained how one of ordinary skill in the art would have been motivated to select the references and to combine them, or would have selected these components for combination in the manner claimed to render the claimed invention obvious.

Here, the Board cited the art of facsimile machines and multi media networking as additional prior which in combination with ARC's disclosures renders Applicant's invention obvious. Notwithstanding that the Board has misinterpreted and misconstrued ARC's disclosures as explained above, the Board has not explained how the technology involved in that art functions to render Applicant's invention obvious as required by In re Lee. Then too, as Applicant explained herein, the operation of the facsimile transmission is different from Applicant's claimed method and the multi media citation at best only concerns the data transmission step of Applicant's claimed method. Thus, the Board's decision does not consider Applicant's invention as a whole and runs afoul of this well accepted principle of law.

The Board's decision makes no attempt define the level of ordinary skill in the art of the invention as required by Graham v. John Deere, 383, U.S. 1 (1966) and In re Greene, supra. This lack of determination is sufficient in and of itself to render the Board's decision clearly erroneous.

Accordingly, the Board's decision does not comply with the required factual findings for a prima facie case of obviousness. That is, the Board has not determined the scope and content of the prior art; the level of ordinary skill in the art; or, the differences between the prior art and the claimed invention, Graham v. John Deere; In re Greene, supra.

APPLICANT'S REBUTTAL TO THE BOARD'S FINDING OF OBVIOUSNESS

Notwithstanding that Applicant does not agree that the Board has made a showing of a prima facie case of obviousness, the following rebuttal is submitted.

35 U.S. § 103 is the ultimate controlling authority as interpreted by the Federal Circuit for the issue of obviousness, which in effect states that a person cannot obtain a patent if the subject matter of the invention is considered obvious to a person of ordinary skill in the art to which the invention pertains, *Graham v. John Deere, supra*. In assessing the issue of obviousness the factors to be considered are: 1) the scope and content of the prior art; 2) the level of ordinary skill in the art; 3) the differences between the prior art and the claimed invention, *Id.*

The prior art as stated by the Board are the ARC disclosures, the facsimile machine and a multimedia networking arrangement. As noted above, Applicant's position of the ARC disclosures is that paper agent coupons can be eliminated provided that an image of the agent coupon is optically stored. The Board's interpretation of the ARC disclosures is that optical storage of an agent coupon image data should be stored. With regard to these different interpretations of what the ARC disclosures teach or suggest, Applicant incorporates herein all of the above statements and arguments pertaining to this factor. Accordingly, Applicant submits that the Board's interpretation is unwarranted and not supported by the record. On the other hand, Applicant's interpretation of the scope and content of the ARC disclosures are as stated in the IAH handbook published at the time of the application as well as all of the statements made by Arc with regard thereto

"If you're using a type of optical storage media, we're talking about capturing the image of the coupon, not creating a database."

Allan Muten, ARC corporate communications director, as reported in the Travel Weekly News dated 6/20/2000 (doc. AM, Form PTO 1449)

Applicant submits that the above single quote by ARC and the consistent IAH statements of 200 and 2005, firmly put to rest any question of the interpretation of the ARC disclosures. Nothing could be more clear. Applicant's interpretation is correct,

the Board's is erroneous. In view of the only supportable interpretation of the ARC disclosures, the facsimile and multi media networking references cited by the Board are totally inapplicable or at the very best apply to one step of the Applicant's claimed invention, as explained above. In either event, the combination of the references do not teach or suggest Applicant's claimed invention; or in the alternative do not address Applicant's invention as a whole. Accordingly, the Applicant has rebutted the Board's determination of the scope and content of the prior art. Applicant has also shown that the differences between the prior art and the claimed invention do not support a finding of obviousness, see the above. (Applicant still maintains that the Board has not shown any authority to support a different conclusion, as explained above).

In its decision, the Board has not made any attempt to determine the factor regarding the level of ordinary skill in the art. Attached hereto as Exhibit 4 is a declaration of the Applicant that shows the history of his invention and that his level of skill in the art is superior to one of ordinary skill and.

The attached copies of the pertinent portion of the 2005 IAH (Exhibit 2) reveals that ARC is still disclosing the need to optically capture the image of the agent coupon as did the 2000 IAH (Exhibit 1) at the time of the application. Thus, it is shown that ARC and others, other than Applicant, have failed to make Applicant's invention for over 5 years based on ARC's disclosures. Even if the level of skill in the art is considered high, the failure of others to make Applicant's invention for at least 5 years based on ARC's disclosures evidences that a person of ordinary skill has not considered Applicant's invention obvious. That Applicant's invention has satisfied a long felt need is also shown by the years apart statements by ARC regarding the same optical storage of the image of the agent coupon disclosures by ARC.

Accordingly, a full and supportable determination of the Graham V. John Deere factors, as advanced herein leads to the only conclusion that Applicant's invention when taken as a whole, without the prohibited use of hindsight, was not obvious to a person of ordinary skill in the art to which the invention pertains, at the time of the application.

Rebuttal evidence is merely a showing of facts supporting the opposite conclusion and may relate to the Graham factors including the secondary considerations, In re Plasecki, 745 F.2d 1468 (CAFC 1984). If rebuttal evidence of adequate weight is produced. The holding of a prima facie case of obviousness is dissipated. Moreover, the Examiner must consider all of the evidence anew regardless of the strength or weakness of the prima facie case, *id.* In accordance with the above submitted evidence, Applicants submits that the showing, if any, of a prima facie case of obviousness is dissipated.

THE ARC DISCLOSURES TEACH AWAY FROM APPLICANT'S CLAIMED INVENTION

In the prior art as explained in the specification of the application, the agent coupon was printed along with the printing of the airline ticket. In stead of printing and storing paper agent coupons, ARC wanted the image stored in an optical media, e.g. microfiche. It absolutely did not want the agent coupon data to be stored, see the ARC Industrial Agents' Handbook quoted above and attached hereto as Exhibits 1 and 2, respectively. Accordingly in a direction away from ARC's teaching, the Applicant invented the method of generating agent coupon data by extracting the data from the prior art agent reservation system, as shown in Figure 1 of the drawings, during the time that the airline ticket was being printed. Then the generated coupon data was separated from the prior art reservation system, identified and the data was electronically stored for future printing in the exact form of a prior art agent coupon, all in a manner not previously known or suggested. Applicant's invention therefore achieves the ability to completely eliminate the printing of an agent coupon during the printing of an airline ticket and not storing an optical image of the coupon. Applicant's claimed invention further provides the ability to print an exact copy of the agent coupon at a future time from the stored data and not from a stored image of the coupon. In this regard, Applicant's claimed invention is completely different and away from ARC's disclosures or any suggestion in ARC's disclosures.

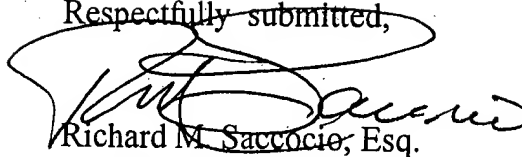
Moreover, as explained above, the Board's reference to Facsimile transmission is inapplicable in that said technology transmits an image and not data. The Board's reference to multi media networking also falls short of showing obviousness in that it may refer or be applicable to but one step in Applicant's claimed invention and not the invention as a whole.

With regard to an issue of obviousness a reference that teaches away is a significant factor to be considered in determining obviousness. A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant. In general, a reference will teach away if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the relief sought by the applicant. In re Gurley, 27 F.3d 551 (CAFC 1994). Applicant submits that it is inconceivable to find that or reach any conclusion other than the 2000 and the 2005 IAH handbooks teach away from the path taken by Applicant. The path taken by applicant completely eliminates the need to print and then optically store the image of an agent coupon. ARC's disclosures do not render Applicant's claimed invention obvious.

CONCLUSION

The Board has not shown a prima facie case of obviousness in its decision; or in the alternative, and assuming without conceding that it has, Applicant has authoritatively, sufficiently and adequately rebutted the finding of obviousness. Applicant respectfully requests that Board reopen prosecution, remand the proceeding to the Examiner, and that The Examiner allow the application in its present form

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Richard M. Saccocie", is written over the typed name.

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Dated March 24, 2005

Field Investigations and Fraud Prevention Program

Storage of Agent Sales Reports,
Supporting Documents, and Sales
Summaries on Microfiche/Microfilm or
Other Optical Storage Media

Section XIV of the Agent Reporting Agreement requires each ARC Agent to retain, for at least two years, a duplicate copy of each weekly sales report and all supporting documents, (i.e., the agent coupons, RENS, credit card charge forms, settlement authorization forms, calculator tapes, computer print-outs, sales summaries, voids, and other supporting documents). Most Agents satisfy this contractual requirement by maintaining these required documents in the agency location in "hard copy" paper form.

As an alternative to maintaining the sales report and supporting documents in paper format, an Agent may, upon prior written notice to, and written approval by ARC, maintain the required documents on microfiche/film or on an optical storage medium as specified below, under the following conditions.

- (1) The sales reports and all supporting documents must be copied to microfiche/film or to a non-magnetic optical medium that uses a "write-once, read-many" technology which will prevent overwriting the stored data (e.g., WORM technology). Certain non-volatile storage medium, such as CD-ROMs, optical disks, DVDs, and laserdiscs, may be determined to be acceptable storage media. However, computer hard drives, zip drives, floppy disks, magnetic tape, and other magnetic media are **NOT** acceptable.
- (2) Each weekly sales report and all supporting documents stored on microfiche/film or on an optical storage medium must be accessible by an ARC representative or a carrier representative in accordance with the terms of section XIV of the Agreement.
- (3) A functional reader and copier for microfilm/fiche (and a PC and printer for use with an optical storage medium), which allows for the viewing and reproduction of the entire sales report and all supporting documents, must be available to an ARC representative or carrier representative at the site where the microfiche/film or optical copies are stored and maintained.
- (4) The records which are stored optically or on microfiche/film must be direct, complete, and accurate reproductions of the original sales reports, supporting documents and sales summaries, and easily read and reproduced without loss of clarity. Voided tickets, clearly marked as such, may also be

retained optically or in microfilm/fiche; be advised, however, that the Agent is ultimately responsible for the use of any supposedly voided or destroyed ticket. (See, section 12, page 3, of the 2000 Edition of the *Industry Agents' Handbook* for information concerning alternative procedures for maintaining records of voids)

- (5) All stored records must be indexed by sales period ending date so as to be readily accessible to an ARC representative or a carrier representative. Images stored optically also must be retrievable by agency code number, sales period ending date, ticket number and stock control number.
- (6) An Agent who wishes to maintain its records optically or on microfilm/film, shall submit to ARC, in the form prescribed, a written request by an owner or officer, and provide the following information: (a) the manner in which the records will be reproduced and the specific type(s) of storage media which the Agent proposes to utilize; and (b) the agency location(s) where the sales, reports and supporting documents, and the reader(s) and copier(s) will be maintained. The Agent will be required to affirm that the records maintained are direct and accurate reproductions of the original records (i.e., reproductions of the original agent coupons, sales summaries, and other supporting documents). A copy of the "Request to Maintain Sales Reports on Microfiche/Film or Optical Media" may be obtained from ARC's Fax-Back Service (800-811-1608). Requests should be sent to ARC, 1530 Wilson Boulevard, Suite 800, Arlington, VA 22209-2448, Attention: Director - Field Investigation and Fraud Prevention.

[Note: The Agent Reporting Agreement requires Agents to maintain their sales reports and supporting documents for only two years; however, Agents should note that other entities, e.g., governmental or tax authorities, etc., may require such documents and records to be maintained for longer periods of time.]

EXHIBIT
1



Field Investigations and Fraud Prevention Program

Audit Program

The Airlines Reporting Corporation employs a staff of full-time field auditors based in various cities throughout the country. The primary purpose of the audit program is to conduct inspections of the books and records of ARC-accredited Agents, as well as of the traffic documents provided to them, in order to determine compliance with the ARC Agent Reporting Agreement. This activity is conducted pursuant to Section XIV of the Agreement. The principal areas covered during an agency audit are:

- The proper reporting of air transportation sales and ancillary services issued on ARC traffic documents
- Accountability of ARC traffic documents
- Security of traffic documents and airline identification plates
- Proper issuance of ARC traffic documents
- Ownership verification

Agency records normally needed to conduct the audit include:

- Weekly sales summaries and supporting documents covering the past two years
- Related invoices, reservation cards and/or journals
- Voided traffic documents

Audits are assigned on the basis of information developed by ARC and/or received by ARC from carriers, the area banks and, to a lesser extent, other agents.

The auditor will give the Agent reasonable notice, appropriate to the circumstances, prior to commencing an audit. However, due to the nature of the audit function, scheduling logistics, and priorities, a specific time and date cannot always be arranged. The auditor is aware that an agency is engaged first and foremost in servicing its clients, and every effort is made to conduct the audit inconspicuously and without disruption of routine office business. The average audit takes about two days to complete, depending on the size of the agency. Arrangements should be made to provide the auditor with suitable work space in the agency.

In all cases, the auditors must identify themselves with a pictured identification card prior to commencing the audit. If there should be any doubt as to the person's identity, the Agent should call the ARC Audit Section at 703-816-8008, for verification. The auditor will also explain the scope of the audit and identify the documents to be reviewed. If the

auditor needs to copy certain documents, and copying equipment is not available in the agency, the Agent may accompany the auditor to make the needed copies.

The agency audit program calls for person-to-person contact with the Agent in his or her own place of business. The program's success is measured by its contribution toward the maintenance of a sound and uniform agency program and NOT by the number of violations discovered. The ARC auditors are trained professionals, who have complete knowledge of ARC rules and procedures. In addition, their daily exposure to various types of agency operations throughout the country has equipped them to assist many agents with improved record keeping techniques, reporting procedures, etc. For the vast majority of agents who intend to conduct their business in compliance with the ARC Agent Reporting Agreement, a visit by an ARC auditor can be a constructive and beneficial experience.

Fraud Prevention Program

ARC's fraud prevention investigators each have a minimum of 20 years experience in law enforcement before joining the ARC staff. They deal primarily with the theft and fraudulent use of ARC traffic documents and assist law enforcement agencies throughout the world in the investigation and prosecution of such cases. Suggestions on how agents can help minimize the theft of ARC traffic documents may be found in Section 70.2 of this handbook.

Storage of Agent Sales Reports Supporting Documents, and Sales Summaries on Microfiche/Microfilm or Other Optical Storage Media

Section XIV of the Agent Reporting Agreement requires each ARC Agent to retain, for at least two years, a duplicate copy of each weekly sales report and all supporting documents, (i.e., the agent coupons, RENs, credit card charge forms (UCCCFs), settlement authorization forms, calculator tapes, computer print-outs, sales summaries, voids, and other supporting documents). Most Agents satisfy this contractual requirement by maintaining these required documents in the agency location in "hard copy" paper form.

As an alternative to maintaining the sales report and supporting documents in paper format, an Agent may, upon prior written notice to, and written approval by ARC, maintain the required documents on microfiche/film or on an optical storage medium as specified below, under the following conditions.

- (1) The sales reports and all supporting documents must be copied to microfiche/film or to a non-magnetic optical medium that uses a "write-once, read-many" technology which will prevent overwriting the



stored data (e.g., WORM technology). Certain non-volatile storage medium, such as CD-ROMs, optical disks, DVDs, and laserdiscs, may be determined to be acceptable storage media. However, computer hard drives, zip drives, floppy disks, magnetic tape, and other magnetic media are NOT acceptable.

- (2) Each weekly sales report and all supporting documents stored on microfiche/film or on an optical storage medium must be accessible by an ARC representative or a carrier representative in accordance with the terms of Section XIV of the Agreement.
- (3) A functional reader and copier for microfilm/fiche (and a PC and printer for use with an optical storage medium), which allows for the viewing and reproduction of the entire sales report and all supporting documents, must be available to an ARC representative or carrier representative at the site where the microfiche/film or optical copies are stored and maintained.
- (4) The records that are stored optically or on microfiche/film must be direct, complete, and accurate reproductions of the original sales reports, supporting documents and sales summaries, and easily read and reproduced without loss of clarity. Voided traffic documents, clearly marked as such, may also be retained optically or in microfilm/fiche; be advised, however, that the Agent is ultimately responsible for the use of any traffic documents the Agent reported as voided or destroyed. (See, Section 12, page 3, of the *Industry Agents' Handbook* for information concerning alternative procedures for maintaining records of voids.)
- (5) All stored records must be indexed by sales period ending date so as to be readily accessible to an ARC representative or a carrier representative. Images stored optically also must be retrievable by agency code number, sales period ending date, ticket number and stock control number. Agents using optical disk storage must be able to create an agent coupon image from the stored data on demand.
- (6) An Agent who wishes to maintain its records optically or on microfiche/film, shall submit to ARC, in the form prescribed, a written request by an owner or officer, and provide the following information: (a) the manner in which the records will be reproduced and the specific type(s) of storage media which the Agent proposes to utilize; and (b) the agency location(s) where the sales reports and supporting documents, and the reader(s) and copier(s) will be maintained. The Agent will be

required to affirm that the records maintained are direct and accurate reproductions of the original records (i.e., reproductions of the original agent coupons, sales summaries, and other supporting documents). A copy of the "Request to Maintain Sales Reports on Microfiche/Film or Optical Media" may be obtained from ARC's Fax-Back Service (800-811-1608). Requests should be sent to ARC, 4100 North Fairfax Drive, Suite 600, Arlington, VA 22203, Attention: Director - Field Investigation and Fraud Prevention

Special Note for Agents that Report Sales Electronically Via IAR

- (7) Agents that submit their sales reports electronically via Interactive Agent Reporting (IAR) are permitted to print agent coupon data on non-accountable stock (e.g., mini itinerary documents or plain paper). IAR agents may also have the option of sending the agent coupon data directly to a write-once, read-many, non-magnetic optical medium (e.g., CD ROM, etc). The optically stored images of the agent coupon data must be retrievable by agency code number, sales period ending date, and ticket number. Agents using optical disk storage must be able to create an agent coupon image from the stored data on demand.

Please note, however, that even though an IAR Agent may print the agent coupon data on non-accountable stock or plain paper, or send it to an optical medium, the Agent will be still be required to maintain a copy of each weekly sales report (including the agent coupon data printed on non-accountable paper or stored optically, the original paper copy of all agent coupons for manual traffic documents, and other supporting documents, e.g., UCCCFs) for a period of two years. The stock control number will not be a required data element for agent coupon data which is printed on non-accountable stock or stored in an optical storage medium. IAR agents who wish to store their sales reports on microfiche or an optical medium must follow all requirements in parts (1) through (6) of Section 70.0, except as otherwise noted here in part (7).

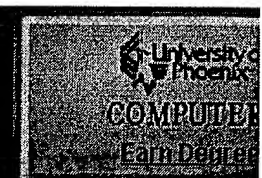
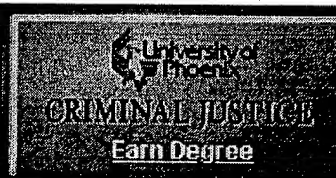
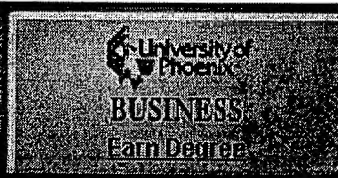
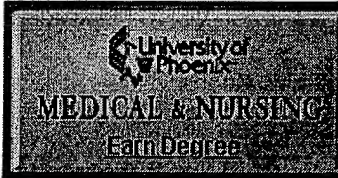
[Note: The Agent Reporting Agreement requires Agents to maintain their sales reports and supporting documents for only two years; however, Agents should note that other entities, e.g., governmental or tax authorities, etc., may require such documents and records to be maintained for longer periods of time.]



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How Fax Machines Work

by [Marshall Brain](#)

You can walk into nearly any office in the United States today, big or small, hi-tech or lo-tech, and you will find a fax machine. Connected to a normal phone line, a fax machine allows you to transmit pieces of paper to someone else instantly! Even with FedEx and e-mail, it is nearly impossible to do business without one of these machines today.



In this article, you'll learn how a fax machine works its magic!

The Basic Idea

Fax machines have been around in one form or another for more than a century -- Alexander Bain patented the first fax design in 1843 (see [Science Line: Alexander Bain & the Fax Machine](#) to learn more). If you look back at some of the early designs, you can get a very good idea of how they work today.

EXHIBIT 3

Most of the early designs involved a **rotating drum**. To send a fax, you would attach the piece of paper to the drum, with the print facing outward. The rest of the machine worked something like this:

- There was a small photo sensor with a lens and a light.
- The photo sensor was attached to an arm and faced the sheet of paper.
- The arm could move downward over the sheet of paper from one end to the other as the sheet rotated on the drum.

In other words, it worked something like a lathe.

The **photo sensor** was able to focus in and look at a very small spot on the piece of paper -- perhaps an area of 0.01 inches squared (0.25 millimeters squared). That little patch of paper would be either black or white. The drum would rotate so that the photo sensor could examine one line of the sheet of paper and then move down a line. It did this either step-wise or in a very long spiral.

To transmit the information through a phone line, early fax machines used a very simple technique: If the spot of paper that the photo cell was looking at were white, the fax machine would send one tone; if it were black, it would send a different tone (see How Modems Work for details). For example, it might have sent an 800-Hertz tone for white and a 1,300-Hertz tone for black.

At the receiving end, there would be a similar rotating-drum mechanism, and some sort of **pen** to mark on the paper. When the receiving fax machine heard a 1,300-Hertz tone it would apply the pen to the paper, and when it heard an 800-Hertz tone it would take the pen off the paper.

Modern Fax Machines

A modern fax machine does not have the rotating drums and is a lot faster, but it uses the same basic mechanics to get the job done:

- At the sending end, there is some sort of **sensor** to read the paper. Usually, a modern fax machine also has a paper-feed mechanism so that it is easy to send multi-page faxes.
- There is some standard way to **encode** the white and black spots that the fax machine sees on the paper so that they can travel through a phone line.
- At the receiving end, there is a mechanism that **marks** the paper with black dots.

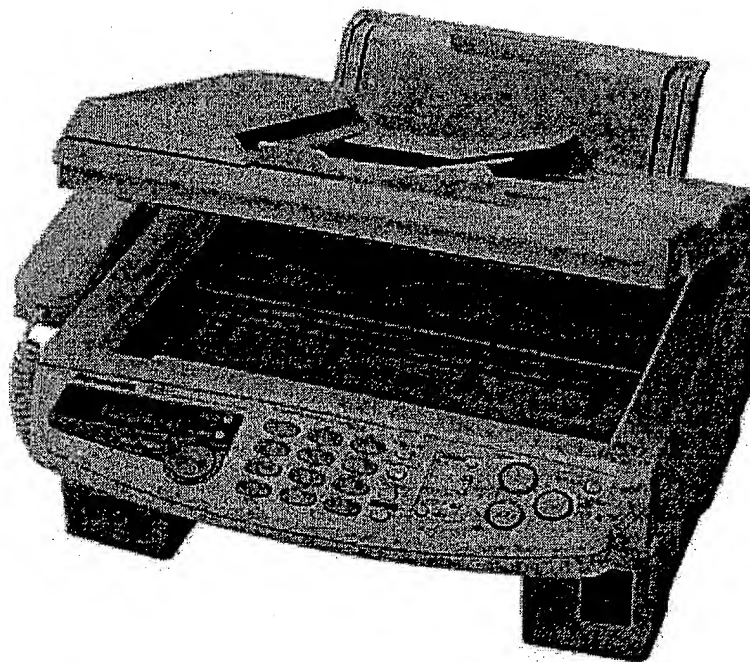


Photo courtesy Panasonic and Matsushita Electric Corporation of America
Panasonic KX-FB421 Fax/Copier machine

A typical fax machine that you find in an office is officially known as a **CCITT (ITU-T) Group 3 Facsimile machine**. The **Group 3** designation tells you four things about the fax machine:

- It will be able to communicate with any other Group 3 machine.
- It has a horizontal resolution of 203 pixels per inch (8 pixels/mm).
- It has three different vertical resolutions:
 - **Standard**: 98 lines per inch (3.85 lines/mm)
 - **Fine**: 196 lines per inch (7.7 lines/mm)
 - **Super fine** (not officially a Group 3 standard, but fairly common): 391 lines per inch (15.4 lines/mm)
- It can transmit at a maximum data rate of 14,400 bits per second (bps), and will usually fall back to 12,000 bps, 9,600 bps, 7,200 bps, 4,800 bps or 2,400 bps if there is a lot of noise on the line.

The fax machine typically has a CCD or photo-diode sensing array. It contains 1,728 sensors (203 pixels per inch), so it can scan an entire line of the document at one time. The paper is lit by a small fluorescent tube so that the sensor has a clear view.

f="http://www.howstuffworks.com/d
 1era3.htm">CCD or photo-diode
 contains 1,728 sensors (283 pixels per
 n an entire line of the document at on
 er is lit by a small fluorescent tube lil
 f="http://www.howstuffworks.com/q



The scanning process: The scanner in a fax machine looks at one line of the sheet of paper. The scan line is shown here in red. It sees a group of black and white spots, shown blown up in the red rectangle at the bottom of the figure. It encodes the pattern of spots and sends them through the phone line.

The image sensor looks for black or white. Therefore, a single line of the document can be represented in 1,728 bits. In standard mode, there are 1,145 lines to the document. The total document size is:

$1,728 \text{ pixels per line} \times 1,145 \text{ lines} = \text{approximately } 2,000,000 \text{ bits of information}$

To reduce the number of bits that have to be transmitted, Group 3 fax machines use three different **compression techniques**:

- Modified Huffman (MH)
- Modified Read (MR)
- Modified Modified Read (MMR)

See Electronics Plus: Facsimile Theory for a discussion of these compression types. The basic idea in these schemes is to look for "runs" of same-color bits. For example, if a line on the page is all white, the modem can transmit a dozen or so bits rather than the full 1,728 bits scanned for the line. This sort of compression can cut transmission time by a factor of at least two, and for many documents much more. A document containing a significant amount of white space can transmit in just a few seconds.

Receiving the Fax

The bits for the scanned document travel through the phone line and arrive at a receiving fax machine. The bits are **decoded**, **uncompressed** and **reassembled** into the scanned lines of the original document. There are five common ways to print the fax, depending on the type of machine that receives it:

- **Thermal paper** - When fax machines started infiltrating offices en masse in the 1980s, most of them used thermal paper. The paper is coated with chemicals that react to heat by turning black. Thermal paper has several big advantages:
 - It is very inexpensive to build a thermal printer.
 - Thermal printers have no moving parts except for the paper-feed mechanism.
 - There are no expendables like ink or ribbons because the paper contains the ink.

- Thermal printers are nearly indestructible.

The only disadvantage is that the paper discolors over time, and it turns completely black if you leave it in a hot car.

- **Thermal film** - Thermal film uses a page-width ribbon that contains ink that melts onto paper when heated. This is more complicated mechanically than thermal paper but less complicated than an inkjet.
- **Inkjet** - This technique uses the same mechanism as an [inkjet printer](#).
- **Laser printer** - This technique uses the same mechanism as a [laser printer](#).
- **Computer printer** - The fax is actually received by a **fax modem** (a modem that understands the Group 3 data standards), stored on the computer's [hard disk](#) as a graphics file and then sent to the computer's usual printer.

For more information on fax machines and related topics, check out the links on the next page.

Lots More Information

Related HowStuffWorks Articles

- [How Modems Work](#)
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- [How Inkjet Printers Work](#)
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More Great Links

[Click here to add your site to this list](#)

- [Facsimile Theory](#) - good discussion of compression and encoding schemes
- [Webopedia: CCITT](#)
- [Federal Standard Telecommunications: Group 3 Facsimile Apparatus For Document Transmission](#)
- [File Format for Internet Fax](#)
- [Descriptions of Modem Standards](#)
- [Thermal paper](#)
- [A Short Research Project into the Permanence of Thermal Fax Papers](#)

IN THE UNITED STATES PATENT OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex Parte Rodger Burrows

Appeal No. 2004-2110
Application No. 09/910,654

**DECLARATION OF APPLICANT RODGER BURROWS IN SUPPORT OF
THE REQUEST TO REOPEN PROSECUTION**

1. My name is Rodger Burrows, I reside at 2 Redwood Circle, Plantation Fl 33317. I am the inventor of the above referenced application.
2. My experience and expertise forms part of this Declaration
3. On or about October 15, 2000 I learned that ARC (Airline Reporting Corporation) was considering the elimination of paper copies of travel agent coupons. However, ARC required that the agent coupon be stored on microfiche/film or on a non-magnetic type of optical storage. ARC was emphatic in that they did not want the data associated with the agent coupon to be stored; they wanted an actual image of the agent coupon to be stored as stated in the IAH.
4. Based on my previous development of computer software for the travel industry and my substantial computer skills, I began to investigate the requirements announced by ARC. I realized that the procedure required by ARC first required an image of an agent coupon to be printed as in the past because that is the only way the travel agent reservation system worked, then the coupon had to be scanned and optically stored. I further realized that this required procedure allowed the travel agent to throw away the printed copy of the agent coupon but in reality required more effort by the travel agent to scan and then store the optical image of the agent coupon. The onus was also put on the travel agent to determine how to set up the particular optical storage he was going to use and how he was going to retrieve a single agent coupon among the many he had to optically store. That is why ARC also required the travel agent to submit his procedure to ARC for approval. Based on my considerable computer skills and detailed knowledge of the travel agent business and the computer capabilities of most travel agents, it is my belief that very few travel agents actually went to optical storage. Thus ARC's proposal created more work by requiring the printing then scanning on to microfiche the image of the coupon, as well as the need to devise a system that ARC would approve. Once the coupon is copied it

EXHIBIT 4

can be discarded however due to the nature of the document it must be disposed of in a secure and expensive manner. I knew there had to be a better way.

5. After learning of the problem announced by the ARC to be solved by travel agents, I began to investigate how a system referred to as the "Ticketing Control Program" I had begun to develop in 1997 and brought into use by 1999 could resolve this dilemma. However, my system would involve data storage and not image storage as required by ARC. Notwithstanding that ARC's proposal prohibited data storage to solve the problem, in my mind I knew this was a better way to achieve what ARC wanted to do and in doing so would eliminate the extra effort and work by the travel agent that accompanied ARC's proposed system. The problem was how to make my idea work and be acceptable to ARC. Even though my idea was to store coupon data, in the end I knew that I had to be able to somehow later retrieve the particular data associated with a particular transaction from all of the transactions that had occurred since the particular transaction occurred, and from it reconstruct an actual image of an agent coupon. I further realized that I had to work with the then existing travel agent reservation system.
6. While working on my idea, the thought came to me to somehow be able to use the coupon printing aspect of the then reservation system. One problem was that I could not cause any disruptions or interfere with the operation of the reservation system. My idea and the reservation system had to be able to work together and not interfere with each other.
7. After considering a number of approaches to the problem and discarding all of them, I concentrated on the printing aspect of the agent reservation system. I decided to the best way to solve the problem was to generate the agent coupon data by the reservation system while the airline ticket was being printed, extract the generated data and then operate on the generated and separated data so as to be able to store and identify individual agent coupon data among the many that would be generated using the reservation system; but, the I had to be able to retrieve the data from a particular transaction and reconstruct it in an actual image of an agent coupon. This unique method comprised my invention
8. My invention took my particular knowledge of the travel agency business and my significant computer skills to formulate my invention and know that it would work. Even though the level of skill of computer programmers is high, a, ordinarily skilled computer programmer would not have been able to formulate the steps to my invention because of a general lack of knowledge of the travel agency business and ARC's requirements. Even a computer programmer having my skills and given the problem to be solved would not have been able to formulate the steps to my invention because of his lack of knowledge of the travel agency business. Of course, once a competent and sufficiently skilled computer programmer was given the problem to be solved and my solution to the problem comprising the steps to my invention that programmer would have been able to develop the programs necessary to implement my invention. On the other hand the level of computer skills of an ordinary travel agent is quite low and therefore an ordinary travel agent would not have been able to even think of my invention let alone consider it obvious.

9. In order to prove that my invention would work, I developed a program to emulate the printer of a travel agency reservation system. For confidentiality reasons, and to assure myself that once my invention was disclosed, a competent computer programmer could generate the programs necessary to make my invention work, I hired out to other computer programmers various portions of the programs involved in the steps of my invention. No one programmer was given the entire steps to my invention. After the programs were completed, I combined the same in accordance with the steps of the invention. My invention worked. I had proven it and the fact that once given the steps to my invention and the problem to be solved, together with acquiring some knowledge of the operation of a typical travel agent reservation system, an ordinarily skilled programmer could make and use my invention with little experimentation, if any, once a patent on the same had expired.
10. It is to be noted, that in developing my invention, I had to use thinking that differed from the proposed system proposed by ARC. ARC only disclosed or proposed the problem to be solved by the use of optical storage of an exact image of the agent coupon. My invention proceeded in a completely different direction and did not include the disadvantages inherent in the proposed problem to be solved by ARC. Contrary to the direction envisioned by ARC, my invention involves the storage of data and not an image. Once I had disclosed my invention to ARC and demonstrated how it completely eliminated the printing of paper agent coupons and that an exact image of any agent coupon could be reconstructed from the stored data at a later time after many transactions had occurred, ARC was truly amazed and quickly approved the use of my invention.
11. After having disclosed my invention to ARC and shown that it worked, I later learned that ARC had subsequently and surreptitiously embarked upon a program to copy my invention and did so. It is known as Compass. That was the basis of making my invention special.

Statement Of My Skills

12. In 1984 after graduating from the Southern Ohio College in Fairfield Ohio with an associate's degree in computer science I trained myself in PC computer software. This was necessary due to the fact that at the time colleges were only teaching mainframe operation systems and languages. Specifically the language I first taught myself was called dBase II. This was a database language written in assembly that allowed for system calls to the computer OS and could be used both on MS DOS and the CP/M operating systems. Since the database language I was learning was portable to both of these operating systems it was necessary for me to train myself how to use them both. At the time there were no classes available to learn either the operating system or the computer languages. In fact once the college I graduated from found out that I know them they asked me to teach a course, which I did.
13. At the time the predominant operating system was produced by Digital Corporation however it was my belief that IBM PC's and MS DOS would

become a dominating factor in the future. (I wish that I would have had the money to buy stock then) I became an expert in the use of dBase II and created a company that sold accounting software written in the language and made custom modifications to the source code for my customers.

14. In 1989 I decided to move to Florida and began to seek employment there. The owner of a travel company was impressed with my computer skills and I was employed there until 1991 when I moved to another travel agency in south Florida. During my time at the first agency my experience included working as a IBM System 36 computer operator. Installation of STP's (satellite ticket printers) at remote customer sites. Training of employee's in the use of personal computers and the installation of PC computer software. When I moved to the second travel agency my responsibilities included being an AS/400 system operator. I was then also responsible for the implementation and oversight of all computers and software in the main agency and all 50 branches. This meant I had to be well versed in the implementation and maintenance of every computer related aspect of a travel agency.
15. In 1992 I started working as a consultant for a company that specialized in accounting software for travel agencies. I worked for that company until 1996 when I started my own company selling the accounting software myself. My close interaction with both large and small travel agencies gave me an unusual degree of detailed knowledge into the accounting and of necessity all aspects of the travel business. As you can imagine it was necessary for me to know exactly how the companies worked to be able to account for income and expenses.
16. In 1997 I began to look into the workings of the agent reservation system for the purpose of adapting the system to perform a function that it was not intended to do. I wanted to sequentially print tickets in accordance with a person's travel itinerary on a cruise. Since this is an area that had been of interest to me because of my computer skills and my travel agent experience, I became fairly well well versed in how the reservation system worked. I began developing my Ticket Control Program and by the middle of 1999 it was ready to be put to use. The methods and systems employed in the Ticket Control Program, in part, enabled me to solve the problem accomplished by my present invention. Without this previous knowledge, I am of the belief that my present invention would not exist. This previous knowledge allowed me to invent my claimed invention in the direction opposite to that envisioned by ARC.
17. Upon information and belief, there is no question in my mind and I am of the opinion, in view of my considerable computer skills, intimate knowledge of the travel business, and my detailed knowledge of the travel agent reservation system, that no one person of ordinary skill in the field of my invention at the time of my invention, would have considered it obvious.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the

like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code.

Rodger Burrows 3-25-05
Rodger Burrows Date



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,654	07/20/2001	Rodger Burrows	02154.001	2617

7590

05/24/2005

Richard M. Saccocio
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EXAMINER

MYHRE, JAMES W

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 05/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/910,654

Applicant(s)

BURROWS, RODGER

Examiner

James W Myhre

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15, 17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 17 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The Request to Reopen Prosecution and Response to the January 25, 2005 Board of Patent Appeals and Interferences (BPAI) Decision filed on March 28, 2005 under 37 CFR 41.50(b)(1) has been considered but is ineffective to overcome the ARC references. The currently pending claims considered below are Claims 1-15, 17, and 18.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
3. Claims 1-15, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over ARC references submitted by the Applicant.

Claims 1-15, 17, and 18: The BPAI Decision presented the following rejection of these claims as being obvious over the ARC references:

"We reject Claims 1-15, 17, and 18 under 35 U.S.C. 103(a) as being unpatentable over the prior art submitted by the appellant which has collectively been labeled ARC. We incorporate the finding made by the examiner in rejecting these claims under 35 U.S.C. 102(f) except for the finding that ARC discloses the electronic

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storage of coupon data. Even though we found above that ARC does not disclose the electronic storage of coupon data as asserted by the examiner, we agree with the examiner's position that the storage of coupon data electronically would have been obvious to the artisan in view of the teachings in ARC that coupon data should be stored in optical form. At the time this application was filed, it was well known in the art to store image data in electronic form so that it could be transmitted over a communications channel such as a facsimile transmission or a multimedia network transmission. Thus, although ARC in its entirety seems to suggest an optical storage of image data, the artisan would have found it obvious to also store the image data in electronic form for subsequent reconstruction of the image."

The Examiner adds that as cited by the Applicant in the Response in Exhibits 1 and 2 (the 2000 IAH and 2005 IAH references) "ARC stated...all supporting documents must be copied to microfiche/film or to a non-magnetic optical medium that uses 'write-once, read only' technology which will prevent overwriting...However, computer hard drives, zip drives, floppy disks, magnetic tape, and other magnetic media are NOT acceptable. (emphasis in the original)". This passage teaches one of ordinary skill in the art (i.e. artisan) that the supporting documents (including the agent coupon) could be stored on microfiche, microfilm, non-magnetic optical medium, computer hard drives, zip drives, floppy disks, magnetic tape, and other magnetic media, but that such storage would not be acceptable to the ARC, except for the first three. This clearly discloses that alternate means for storing the supporting documents were not only known at the time, but also considered by the ARC. Whether or not the ARC would accept storage of

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the agent coupon data on a certain type of storage media does not remove the teaching of such by the above passage. The rules and regulations are subject to change by the ARC at any time. The requirement to store an agent coupon may be eliminated altogether in the future, additional forms may be added to the required storage list, or a new type of storage medium may be developed and accepted by the ARC in the future. However, none of these possibilities would remove the obviousness of storing the agent coupon data (or any other documents or forms) on the various types of storage mediums available at the time.

Response to Arguments

4. Applicant's arguments filed March 25, 2005 have been fully considered but they are not persuasive.

a. The Applicant argues "that ARC only disclosed the storage of an optical image of the agent coupon and not electronic storage of agent coupon data" (pages 2-5). The Examiner notes that in the passages from the 2000 IAH and 2005 IAH references cited by the Applicant in the Response, the ARC discloses that the agent may "maintain the required documents on microfiche/film or **on an optical storage medium**"... "which will prevent overwriting" (emphasis added). This citation does not state that an optical image of the agent coupon is being stored, only that the required documents (which would include the agent coupon) may be stored on an optical storage medium that cannot be overwritten. Such optical storage media known at the time were CDs, DVDs, WORM disks, etc. Many of these devices would have met the write-once,

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read only criteria of the ARC. For example, the *Microsoft Computer Dictionary, Third Edition*, printed in 1997, defines "compact disc" as "An optical storage medium for digital data" and when defining "compact disc – erasable" states "Contemporary CDs are 'write once, read many', in that the information originally written cannot be changed, but can only be appended to." (page 104). Thus, as the rejection in the BPAI Decision concludes, it would have been obvious to an artisan at that time to store the agent coupon and the other supporting documents as digital data on an optical storage medium such as a CD.

b. The Applicant's argument that the invention achieved the same goal as the ARC but not by using the same method disclosed or suggested by the ARC (pages 5-6) is not persuasive. As discussed above, the ARC discloses various types of storage medium upon which the supporting documents could be stored, but placed a caveat on what criteria had to be met by the storage medium before it would be accepted to the ARC, namely that the storage medium could not be overwritten. The Examiner notes that in Claim 3 the Applicant is claiming that the storage medium used in the invention is a hard drive, one of the storage mediums explicitly mentioned (suggested) by the ARC. Thus, the invention is achieving the same goal as the ARC and using a method at least suggested by the ARC.

c. The Applicant argument that the Board's reference do not teach the applicant's invention (pages 7-8) is not persuasive and has been addressed in the responses above.

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d. The Applicant's argument that the Board has not made a showing of a prima facie case of obviousness (pages 8-13) is not persuasive and has also been addressed in the responses above.

e. The Applicant's argument that the ARC disclosures teach away from the Applicant's claimed invention (pages 14-15) are not persuasive. As discussed above, the passages cited by the Applicant explicitly teach various types of storage mediums upon which the data could be stored, but then select the ones which the ARC finds acceptable (e.g. ones that cannot be overwritten). A reference which teaches a plurality of alternatives does not teach away from a disclosed alternative by selecting a different alternative as the preferred embodiment.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

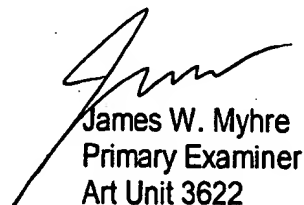
Art Unit: 3622

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (571) 272-6722. The examiner can normally be reached Monday through Thursday from 5:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (571) 272-6724. The fax phone number for Formal or Official faxes to Technology Center 3600 is (703) 872-9306. Draft or Informal faxes, which will not be entered in the application, may be submitted directly to the examiner at (571) 273-6722.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (571) 272-3600.


JWM
May 18, 2005


James W. Myhre
Primary Examiner
Art Unit 3622

In re The Application Of:

INVENTOR(S): Rodger Burrows



GROUP ART UNIT: 3622

SERIAL No.: 09/910,654

EXAMINER: Myhre, James W.

FILING DATE: 7/20/01

TITLE: METHODS AND APPARATUS FOR ELECTRONICALLY STORING
TRAVEL AGENT COUPONS

APPENDIX C
37 CFR § 41.37(c)(1)(x)

RELATED PROCEEDINGS APPENDIX

Pursuant to 37 CFR § 41.37(c)(1)(x), Applicant submits this Appendix of
Related Proceedings which consists of the decision by this Board Mailed January 25,
2005, further comprising:

Decision On Appeal, Appeal No. 2004-2110, Application No. 09/910,654,
Heard on December 8, 2004.

Copy attached.

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 23

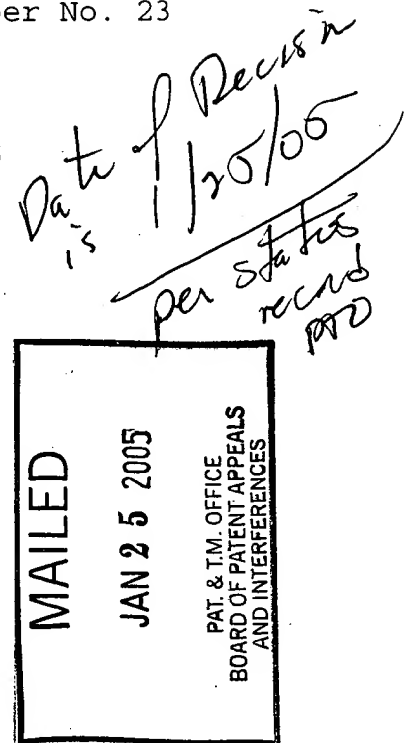
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RODGER BURROWS

Appeal No. 2004-2110
Application No. 09/910,654

HEARD: DECEMBER 8, 2004



Before JERRY SMITH, RUGGIERO, and GROSS, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-18, which constituted all the claims in the application. An amendment after final rejection was filed on October 17, 2003 and was entered by the examiner. This amendment cancelled claim 16. Therefore, this appeal is directed to the rejection of claims 1-15, 17 and 18.

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The disclosed invention pertains to a method and apparatus for electronically generating, storing and retrieving airline ticket agency coupon data.

Representative claim 1 is reproduced as follows:

1. A method for electronically generating, storing, and retrieving airline ticket agency coupon data, comprising the steps of:

generating agent coupon data simultaneously with the printing of an airline ticket;

transmitting and storing said agent coupon data electronically to and in data storage apparatus;

providing each agent coupon data with an identifier;

storing said agent coupon data in a director/directory/image file arrangement; and

retrieving said electronically stored agent coupon data and printing the same in a format of an agent coupon.

The examiner relies on the following references:

Friedes et al. (Friedes) 5,521,966 May 28, 1996

"Field Investigations and Fraud Prevention Program," Industry Agents' Handbook, pp. 1-2, (Section 70.0, 2000 Ed.) (Hereinafter referred to as IAH).

Prior art submitted by appellant relating to events involving Airlines Reporting Corporation (ARC).

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Claims 1-15, 17 and 18 stand rejected under 35 U.S.C. § 102(f) because appellant did not invent the claimed subject matter. Claims 1-15, 17 and 18 also stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness the examiner offers Friedes in view of IAH.

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon does not support the rejection of the claims under 35 U.S.C. § 102(f). We are also of the view that the prior art relied upon does not support the examiner's

rejection of the claims under 35 U.S.C. § 103. Accordingly, we reverse. We enter a new rejection, however, using our authority under 37 CFR § 41.50(b).

We consider first the rejection of claims 1-15, 17 and 18 based on the examiner's finding that appellant did not invent the subject matter of the claimed invention. The examiner's finding results from the examiner's consideration of the prior art submitted by appellant representing events involving the Airlines Reporting Corporation (ARC). It is essentially the examiner's position that the claimed invention represents nothing more than the recitation of a new policy proposed by ARC in which agent coupon data could be stored electronically rather than in paper form (answer, pages 3-5).

Appellant argues that independent claims 1 and 15 recite the storage of agent coupon data electronically whereas ARC only describes the storage of agent coupon data as an actual image of the agent coupons. Appellant argues that there are several disclosures within ARC that indicate that ARC was only proposing the storage of an image of an agent coupon and not the electronic

storage of agent coupon data. Appellant also notes that the rejection is not based on a single document as required, but instead, is based on a plurality of separate documents by ARC and the Travel Weekly News (brief, pages 9-15).

The examiner responds that ARC disclosed that agents "can now print agent coupon[s] on non-accountable stock or capture the coupon data on an optical media" (answer, page 5, emphasis added by examiner). The examiner finds that the disclosure of capturing coupon data indicates that the data is stored electronically. The examiner also notes that it would have been obvious to store the data as an image file or a text file. The examiner notes that it was well known that image data can be stored in electronic form for reconstruction of the image (answer, pages 6-11).

Appellant responds that when all of the disclosures of ARC are considered as a whole, it is clear that ARC did not contemplate the electronic storage of agent coupon data (reply brief, pages 2-5, 7-11).

We will not sustain the examiner's rejection of the claims on appeal under 35 U.S.C. § 102(f). We agree with appellant that ARC, when considered in its entirety, only

discloses that agent coupon data should be stored in optical form. The attempt by the examiner to read electronic storage of coupon data into the ARC disclosure is based on speculation.

Although the examiner has given reasons why the electronic storage of the coupon data would have been obvious to the artisan in view of ARC, the rejection before us is based on anticipation and not on obviousness. We address this question of obviousness in our new ground of rejection set forth below.

We now consider the rejection of claims 1-15, 17 and 18 under 35 U.S.C. § 103 based on the teachings of Friedes and IAH. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073-74, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally

available to one having ordinary skill in the art. Uniroval, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039-40, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those

arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived (see 37 CFR § 41.37(c)(1)(vii)(2004)).

With respect to independent claims 1 and 15, the examiner's rejection is set forth on pages 5-6 of the answer. The examiner essentially finds that since Friedes teaches the electronic sale of an airline ticket, and since IAH allowed the electronic storage of an agent's coupon, then it would have been obvious to the artisan to maintain the agent coupon data in Friedes as an electronic file, available for retrieval and printing.

Appellant argues that Friedes is not analogous art because Friedes relates to the paperless storage of images of a smart card whereas the claimed invention relates to the storage of data associated with agent coupons from which an actual facsimile of the agent coupons can be created on demand. Appellant notes that there is no mention of an agent coupon in Friedes. Appellant also argues that there is no suggestion in either reference to combine their teachings in the manner proposed by the examiner. Appellant asserts that the teachings

of the two references would lead the artisan in opposite directions. Appellant also argues that IAH relates to optical storage of coupon data and not to electronic storage of such data (brief, pages 18-23).

The examiner responds that it is inherent that when Friedes generates and stores the electronic ticket information it must also generate and store the agent coupon data as per the ARC regulations. The examiner also argues that ARC and IAH teach that the agent coupon data must be electronically stored (answer, pages 11-14).

Appellant responds that Friedes does not once mention agent coupon data, and that it was error for the examiner to extrapolate the teachings of Friedes to include agent coupon data. Appellant also notes that Friedes does not involve a travel agent so that no agent coupons are necessary and the regulations of the ARC are irrelevant (reply brief, pages 5-7, 11-13).

We will not sustain the examiner's rejection of independent claims 1 and 15. We agree with appellant that there is no reasonable basis for combining the teachings of Friedes and IAH. The entire premise of the examiner's rejection is that an

agent coupon must be generated in Friedes which is governed by regulations established by ARC. There is no mention, however, of a travel agent or agent coupon in Friedes. Friedes appears to be a smart card system for use directly with the airlines themselves. Friedes specifically discloses that "[t]he traveler need not go to a travel agency or airline office in order to obtain the ticket" (column 7, lines 12-13). Friedes also discloses that the smart card is verified by the flight attendant, who presumably works for the airlines, and that the smart card system eliminates the need for a separate document or piece of paper at the conclusion of the transaction (column 7, lines 7-12). Thus, the suggestion that Friedes somehow requires an agent coupon is contrary to the very teachings set forth within the reference. The premise for the examiner's rejection could only come from an improper attempt to reconstruct the claimed invention in hindsight.

Since we have not sustained the examiner's rejection with respect to independent claims 1 and 15, we also do not sustain the rejection with respect to any of the dependent claims.

In summary, we have not sustained either of the rejections as formulated by the examiner. Therefore, the decision of the examiner rejecting claims 1-15, 17 and 18 is reversed. We make the following new ground of rejection using our authority under 37 CFR § 41.50(b).

We reject claims 1-15, 17 and 18 under 35 U.S.C. § 103(a) as being unpatentable over the prior art submitted by appellant which has collectively been labeled ARC. We incorporate the findings made by the examiner in rejecting these claims under 35 U.S.C. § 102(f) except for the finding that ARC discloses the electronic storage of coupon data. Even though we found above that ARC does not disclose the electronic storage of coupon data as asserted by the examiner, we agree with the examiner's position that the storage of coupon data electronically would have been obvious to the artisan in view of the teachings in ARC that coupon data should be stored in optical form. At the time this application was filed, it was well known in the art to store image data in electronic form so that it could be transmitted over a communications channel such as a facsimile transmission or a multimedia network transmission. Thus, although ARC in its entirety seems to suggest an optical storage of image data, the

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artisan would have found it obvious to also store the image data
in electronic form for subsequent reconstruction of the image.

This decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record

Appeal No. 2004-2110
Application No. 09/910,654

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

REVERSED - 37 CFR § 41.50(b)

Gerry Smith

JERRY SMITH)
Administrative Patent Judge)

Joseph F. Ruggiero

JOSEPH F. RUGGIERO)
Administrative Patent Judge)

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ANITA PELLMAN GROSS)
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APPLICATION	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,654	07/20/2001	Rodger Burrows	02154.001	2617

7590

09/15/2005

Richard M. Saccocio
Richard M. Saccocio, P.A.
100 Southeast 12th Street
Ft. Lauderdale, FL 33316

EXAMINER

ART UNIT

PAPER NUMBER

DATE MAILED: 09/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Notification of Non-Compliant Appeal Brief
(37 CFR 41.37)**

Application No.

09/910,654

Applicant(s)

BURROWS, RODGER

Examiner

James W. Myhre

Art Unit

3622

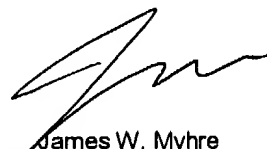
--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The Appeal Brief filed on 05 July 2005 is defective for failure to comply with one or more provisions of 37 CFR 41.37.

To avoid dismissal of the appeal, applicant must file an amended brief or other appropriate correction (see MPEP 1205.03) within **ONE MONTH or THIRTY DAYS** from the mailing date of this Notification, whichever is longer.
EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136.

1. ☒ The brief does not contain the items required under 37 CFR 41.37(c), or the items are not under the proper heading or in the proper order.
2. ☐ The brief does not contain a statement of the status of all claims, (e.g., rejected, allowed, withdrawn, objected to, canceled), or does not identify the appealed claims (37 CFR 41.37(c)(1)(iii)).
3. ☐ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 41.37(c)(1)(iv)).
4. ☒ (a) The brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).
5. ☒ The brief does not contain a concise statement of each ground of rejection presented for review (37 CFR 41.37(c)(1)(vi)).
6. ☐ The brief does not present an argument under a separate heading for each ground of rejection on appeal (37 CFR 41.37(c)(1)(vii)).
7. ☐ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 41.37(c)(1)(viii)).
8. ☐ The brief does not contain copies of the evidence submitted under 37 CFR 1.130, 1.131, or 1.132 or of any other evidence entered by the examiner and **relied upon by appellant in the appeal**, along with a statement setting forth where in the record that evidence was entered by the examiner, as an appendix thereto (37 CFR 41.37(c)(1)(ix)).
9. ☐ The brief does not contain copies of the decisions rendered by a court or the Board in the proceeding identified in the Related Appeals and Interferences section of the brief as an appendix thereto (37 CFR 41.37(c)(1)(x)).
10. ☒ Other (including any explanation in support of the above items):

The Appeal Brief does not follow the new formatting requirements under 37 CFR 41.37(c) which were effective on September 13, 2004. In particular, the "Issues" and "Grouping of Claims" sections have been replaced by a "Grounds of Rejection to be Reviewed on Appeal" section and the Summary of the Invention section has been renamed Summary of the Claimed Invention. Additionally, the Appeal Brief is missing required Appendices B and C. The Applicant is given 1 month or 30 days from the mailing of this notification on non-compliance, whichever is longer, to file an amended appeal brief.


James W. Myhre
Primary Examiner

09-23-05

AP 3622
PFW



PATENT
DOCKET NO.: 2.154.001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BOARD OF PATENT APPEALS AND INTERFERENCES

IN RE: The Application of:

INVENTOR(S): Rodger Burrows

GROUP ART UNIT: 3622

SERIAL No.: 09/910,654

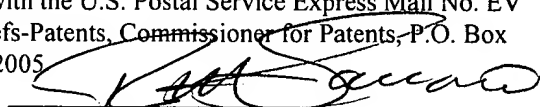
EXAMINER: Myhre, James W.

FILING DATE: 7/20/01

TITLE: METHODS AND APPARATUS FOR ELECTRONICALLY STORING
TRAVEL AGENT COUPONS

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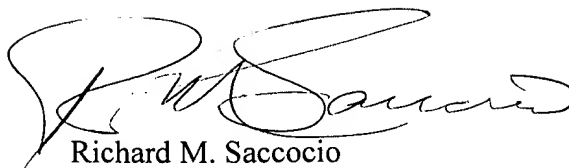
Sir:

TRANSMITTAL LETTER

Transmitted herewith are:

- 1) An original and two copies (in triplicate) of AMENDED BRIEF OF APPELLANT RODGER BURROWS. Said Amended Appeal Brief being in response to the Office Communication mailed September 9, 2005.
- 2) A copy of said Office Communication mailed September 9, 2005 comprising Notification of Non-Compliant Appeal Brief
- 3) Post card.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'R. M. Saccocio', with a large, stylized initial 'R'.

Richard M. Saccocio
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